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88-308

Supreme Court, U.S.
FILED
AUG 10 1988
JOSEPH F. SPANIOL, JR.
CLERK

No. _____

IN THE

SUPREME COURT OF THE UNITED STATES

TERM 1988 - 1989

JAMES N. CONSTANT,

Petitioner

v.

ADVANCED MICRO-DEVICES, INC., et al.,

Respondents *

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

James Constant
1603 Danbury Drive
Claremont, CA 91711
(714) 624-1801

Pro se petitioner

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* see APPENDIX A for a complete list of all Respondents

QUESTIONS PRESENTED FOR REVIEW

1. Whether, absent the determination under 35 USC 302 *et seq.*, the re-examination of patents in the district court denies the patent owner a full trial and due process.

2. Whether the grant to the district court of discretion to determine whether the Patent Office procedure under 35 USC 302 *et seq.* should be utilized and to determine the taxing of costs against patent owners for errors made by the Patent Office in granting patents is inconsistent with due process under the 5th Amendment and the prohibition for imposing excessive fines under the 8th Amendment to the Constitution.

3. Whether the validity of the two patents in suit was decided in conflict with applicable decisions of this Court.

LIST OF PARTIES

See APPENDIX A for a list of parties.

TABLE OF CONTENTS

	Page
OPINION BELOW	1
JURISDICTION	2
CONSTITUTIONAL PROVISIONS INVOLVED	2
STATEMENT OF THE CASE	3
REASONS FOR GRANTING THE WRIT	6
1. Different Standards for Determining Validity of a Patent	6
2. Different Standards for Determining Costs of Reexamination of Patents	8
3. Improper Tests Invalidating Patents	11
CONCLUSION	18

TABLE OF AUTHORITIES

Cases	Page
Graham v. John Deere 86 S.Ct. 684 (1966), 148 USPQ 459	11,15,16, 17.19
In re Foster 343 F 2d 980, 145 USPQ 166 (CCPA 1965)	11
Package Devices, Inc. v. Sun Ray Drug Co., 432 F 2d 272, 167 USPQ 198 (3d Cir 1970) . . .	11
Pittway Corp. v. Black & Decker, Inc., 5USPQ2d 1052, 1057 (DC ND Ill 1987)	12
Stratoflex, Inc. v. Aeroquip Corp. 218 USPQ 871 (Fed Cir 1983). .	11

TABLE OF AUTHORITIES

Statutes	Pages
28 USC 1254(1)	2
28 USC 1338	5
35 USC 102(b) and 103	4,5,11
35 USC 282(2)	5,7
35 USC 302 et seq.	passim
Constitution	
5th Amendment	2,7,10,18
8th Amendment	2,10
Other Authorities	
Public Law 96-517	18
H.R. 96-1307, 96th Congress 2d Session (1980)	18
Chisum, Patents, Section 11.07(4)(c)	6
P. Rosenberg, Patent Law Fundamentals, 15.09(3) 2d ed 1986 . .	9

PETITION FOR WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

The petitioner, James Constant, respectfully prays that a writ of certiorari issue to review the judgement of the United States Court of Appeals for the Federal Circuit decided 9 June, 1988 attached as APPENDIX A.

OPINION BELOW

The Court of Appeals for the Federal Circuit issued its decision affirming the judgement of the United States District Court for the Southern District of California attached as APPENDIX B, invalidating the two patents in suit. By order filed 8 July, 1988 (App. A-64), the Court of Appeals for the Federal Circuit denied petitioner's Petition for Rehearing.

JURISDICTION

The jurisdiction of this Court is invoked under 28 USC 1254(1).

CONSTITUTIONAL PROVISIONS INVOLVED

United States Constitution, 5th Amendment:

> No person shall be . . . deprived of . . . property, without due process of law . . .

United States Constitution, 8th Amendment:

> . . nor excessive fines imposed . .

STATEMENT OF THE CASE

Petitioner filed an action CV 85-0262 for infringement of Constitutional rights, Civil rights, Patent rights, Federal Unfair Competition, Antitrust, and California Unfair Competition. Non-patent claims were immediately dismissed for failure to state a claim upon which relief could be granted.

As to the remaining patent claim, petitioner recommended the Patent Office procedure for reexamination of patent validity and respondents opposed. The court appointed a special master recommended by respondents. Petitioner objected to the master's admitted lack of qualifications in any technology and also objected to the payment of the master's fees and informed the court that appointment of the special master would create financial hardship on him. The court assisted by the

admittedly unqualified master found the two patents invalid under 35 USC 102(b) and 103. Patent 3,950,635 ('635) was found invalid over the Stalcup patent and Allen & Westerfield (A&W) article and Patent 4,438,491 ('491) was found invalid over the Intel Exhibit 5. The court also ordered petitioner to pay the costs of litigation of the validity of the two patents in the amount of $123,832 (App. B-65). The Stalcup and A&W references were generated by the Patent Office and Government R&D respectively. The Intel reference was generated by respondent Intel.

In district court proceedings, for patents and publications, the reexamination of patents under 35 USC 102(b) and 103 is authorized under 35 USC 282(2). In Patent Office proceedings, the reexamination of patents is authorized under 35 USC 302 et seq. The cost of reexamination of a patent in the Patent Office is $1,770.

The district court's jurisdiction for patent claims was invoked under 28 USC 1338.

REASONS FOR GRANTING THE WRIT

1. Different Standards for Determining Validity of a Patent

There are two different standards for determining the validity of a patent. In the Patent Office under 35 USC 302 et seq. the reexamination requires a determination of issue by the Commissioner of Patents (35 USC 303) and reexamination (35 USC 304,305), if an issue is found to exist. Under 35 USC 303, the Patent Office will consider whether references are in the pertinent or analogous art, whether they were not considered in connection with the initial examination and whether they are more pertinent than the prior art that was considered. For authorities and description of the Patent Office Reexamination Procedure see Chisum, Patents, Section 11.07(4)(c).

In the district court under 35 USC 282(2) the reexamination does not require a determination of issue (as would be required in the Patent Office under 35 USC 303).

> "There is no legal authority for the view that the court must first determine that the prior art in the evaluation of obviousness is more pertinent than the prior art considered by the PTO"
>
> App. A-57.

Absent the determination of issue by the Commissioner of Patents (35 USC 303) and absent the Patent Office reexamination, if any, the petitioner was denied a full trial on the materiality of the (Stalcup, A&W, and Intel) references used by the district court to invalidate patents in violation of petitioner's 5th Amendment due process.

2. Different Standards for Determining Costs of Reexamination of Patents

There was no wrongdoing by the petitioner in obtaining the two patents in suit to justify the taxing of costs against him. The two patents were found invalid over references allegedly not considered by the Patent Office in granting patents. *

The court's refusal to utilize the Patent Office procedure under 35 USC 302 et seq. amounts to an abuse of discretion.

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* Absent the determination of the issue by the Commissioner of Patents (35 USC 303) it is not known whether the Stalcup, A&W, and Intel references relied upon by respondents to invalidate patents were considered or that these are more pertinent than the art that was considered in granting patents.

P. Rosenberg, Patent Law Fundamentals, 15.09(3) at 15-167 2d ed 1986 ("In cases which have not progressed beyond . . . initial litigation stage, the reexamination procedure should be utilized)(underline added).

The court abused its discretion in appointing a special master who admits the lack of qualification in any technology.

Thus, the costs taxed against the petitioner were completely unnecessary in view of the low cost proceedure for reexamination in the Patent Office under 35 USC 302 et seq.

The grant to the district court of a wholly standardless discretion to determine whether the Patent Office procedure under

35 USC 302 et seq. should be utilized and further to determine the taxing of costs against petitioner for errors made by the Patent Office in granting patents is a violation of petitioner's 5th Amendment due process and amounts to imposing of excessive fines on the petitioner without good cause in violation of the 8th Amendment to the Constitution.

3. Improper Tests Invalidating Patents

In Graham v. John Deere, 148 USPQ 459 (1966), this Court held that in applying 35 USC 103 the courts should make "several basic factual inquiries". The inquiries are "the scope and content of the prior art", "differences between the prior art and claims at issue", and "the level of ordinary skill in the pertinent art". When secondary evidence appears in the record it should also be considered. Stratoflex, Inc. v. Aeroquip Corp., 218 USPQ 871 (Fed Cir 1983). The same obviousness standard applies to 35 USC 102(b). In re Foster, 343 F 2d 980, 145 USPQ 166 (CCPA 1965); Package Devices, Inc. v. Sun Ray Drug Co., 432 F 2d 272, 167 USPQ 198 (3d Cir 1970).

The sole issue is whether the "several basic factual inquiries" were made in this case. That they were not is evidenced by the record.

The district court's judgements invalidating the two patents were made by a non-technical judge assisted by a special master who admits that he has "no expert qualifications in this or any other technology" and who qualifies only "as a patent lawyer experienced in communicating with such experts" and further admits "I would not be qualified to testify as a technological expert". See Exhibit 16 in appellant's Exhibits in Appeal 88-1101. Pittway Corp. v. Black & Decker, Inc., 5 USPQ2d 1052, 1057 (DC ND Ill 1987)(expert who lacks expertise with rechargeable devices and who admits that he is not a person of ordinary skill in the art failed to show by clear and convincing evidence that re-

chargeable flashlight invention was obvious). The admittedly unqualified master made two technical reports to the court and twice testified under oath on the technical merits of the two patents. The two reports (one for each patent) were submitted privately to the court (see Exh 37 in appellant's Exhibits in Appeal 88-1101) in violation of FRCP 53(e)(1). Two hearings were held (one for each patent) during which the master testified under oath on the technical merits of the two patents. See transcripts for hearings on 30 March, 1987 and 4 May, 1987. The court's decision to invalidate the two patents was announced from the bench at the hearing on 4 May, 1987 at which time the court ordered respondents to submit their proposed findings of fact, conclusions of law and judgement. See the

district court's opinion attached as APPENDIX B. Essentially then, petitioner's patents were tried by a patent lawyer who admits having no technical qualifications in the art in violation of petitioner's demand for a jury trial.

As stated previously, notably absent in the district court's reexamination of the two patents was the Patent Office expert judgement under 35 USC 303 about the materiality of the Stalcup, A&W, and Intel references. In making the "several basic factual inquiries" the court relied solely on the references submitted by respondents as being the prior art for purposes of obviousness determinations. In the case of the '491 patent the court relied on the publications submitted by respondent Intel. App.

A-43 . In the case of the '635 patent the scope and content of the prior art and the differences between the claims at issue and the prior art were ascertained using the submitted documents. App. A -48. Since material cited by the Patent Office was not considered, it is clear that neither the District Court or the Court of Appeals applied the correct test under Graham, supra.

This Court has already "observed a notorious difference between the standards applied by the Patent Office and by the courts". Graham, supra 694. The same observation led Congress to enact 35 USC 302 et seq. as the appropriate standard for the reexamination of patents. In both Graham, supra and 35 USC 303 the prior art consists of material cited by the Patent

Office as well as new material being relied upon by patent challengers. Graham, supra 696, 700.

Equally absent in the district court's reexamination of the two patents was the material for secondary considerations offered by petitioner. See (4)D and (5)D in Appellant's Reply in appeal 88-1101.

But even where the differences between the claims at issue were ascertained using the references submitted by respondents, the results are clearly erroneous. For example, the decision App. A-41 states that the '491 patent is invalid because the specification does not suggest that a computer program is part of the invention. However, such a program is suggested at Col 7 lines 4-8 of the specification and is provided in

the Rabiner and Gold reference given (Appellant's Exhibit 27 in appeal 88-1101). Likewise, the decision App. A-54 states that the '635 patent is invalid because the claims do not involve semiconductor RAMs and $\log_2 n$ lines disclosed in the specification. However, the claims are means claims which "shall be construed to cover the corresponding structure, material or acts described in the specification and equivalents thereof". 35 USC 112 last paragraph. See App. A-56.

From the foregoing it is clear that, the "several basic factual inquiries" required by Graham, supra and intended by Congress in enacting 35 USC 303 were not made in this case with prior art cited by the Patent Office and where made with art relied on by respondents were clearly erroneous.

CONCLUSION

Absent the determination of issue by the Commissioner of Patents (35 USC 303) and absent the Patent Office reexamination, if any, petitioner was denied a full trial on the materiality of the Stalcup, A&W, and Intel references used to invalidate patents in violation of petitioner's right for due process under the 5th Amendment.

And, without any wrongdoing on his part in obtaining patents, the petitioner has and is being subjected to the types of abuses that Congress sought to cure by enacting 35 USC 302 et seq.

> "The reexamination of issued patents should be conducted with a fraction of the time and cost of formal legal proceedings . . .". See House Report on the Bill which became Public Law 96-517, H.R. 96-1307, 96th Congress 2d Session (1980) at 3-4.

The message for the reexamination of patents under 35 USC 302 et seq. has not reached the federal courts and, as demonstrated in the present case, the abuse of persons like appellant continues with impunity. As expressed by 35 USC 302 et seq. patent owners are entitled to the determination of issue by the Commissioner of Patents (35 USC 303) and reexamination (35 USC 304,305), if any, the absence of which in formal court proceedings deprive the patent owner a full trial and expose him to unnecessary costs.

The tests required by Graham, supra and intended by Congress in enacting 35 USC 303 were not made in this case.

For the foregoing reasons, petitioner James Constant respectfully requests that a writ of certiorari issue to review the judgement of the United States Court of Appeals for the Federal Circuit attached as APPENDIX A.

Respectfully submitted

Date:
17 August, 1988

James Constant
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pro se petitioner

CERTIFICATE OF SERVICE

I certify that the foregoing PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT was served on all parties on 17 August 1988 by mailing first class a true and correct copy thereof to them addressed as follows:

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Date: 17 August 1988

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Supreme Court, U.S.
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JOSEPH F. SPANIOL, JR.
CLERK

(2)

No 88-308

IN THE

SUPREME COURT OF THE UNITED STATES

TERM 1988 - 1989

JAMES N. CONSTANT,

Petitioner

v.

ADVANCED MICRO-DEVICES, INC., et al.,

Respondents *

APPENDIX A

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

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* see APPENDIX A for a complete list of all Respondents

APPENDIX A

Contents Page

Opinion Announcing Judgment of the Court A-2

Opinion in Court of Appeals . . . A-6

Order Court of Appeals Denying Petition for Rehearing A-64

UNITED STATES COURT OF APPEALS

FOR THE FEDERAL CIRCUIT

JUNE 9, 1988

OPINION ANNOUNCING

JUDGMENT OF THE COURT

OPINION FILED AND JUDGMENT ENTERED: JUNE 9, 1988.

The attached opinion announcing the judgment of the court in your case was filed today. The judgment was alos entered pursuant to Rule 36.

Costs may be recoverable under Rule 39 or as the court may have directed in the oprinion. A party entitled to costs is provided with a form for that purpose with this notice. Costs when taxed are payable to the party awarded its costs. If costs are awarded to the government,

they should be paid to the Treasurer of the United States. Payment should be made to counsel for the party awarded costs or, if the party is not represented by counsel, to the party pro se. Costs should be paid promptly.

If the court also imposed monetary sanctions, they are payable to the opposing party unless the court's opinion provides otherwise. Sanctions should be paid in the same way as costs.

FRANCIS X. GINDHART

Clerk

UNITED STATES COURT OF APPEALS

FOR THE FEDERAL CIRCUIT

88-1101

JAMES CONSTANT,

Plaintiff-Appellant,

v.

ADVANCED MICRO-DEVICES, INC., GOULD, INC., AMERICAN MICROSYSTEMS, INC., ANALOG DEVICES, INC., FUJITSU, LTS., FUJITSU MICROELECTRONICS, INC., DIGITAL SWITCH, INC., GRANGER ASSOCIATES, INC., HITACHI CORPORATION, INTEL, INC., INTERACTIVE CIRCUITS & SYS., LTS., MATSUSHITA ELECTRONICS CORP., COMPUTER MODULES, INC., NIPPON ELECTRIC CO., LTD., NEC ELECTRONICS USA, PARADYNE DORPORATION, SEMICONDUCTOR PRODUCTS, TEXAS INSTRUMENTS, INC., and TRW INC.,

Defendants-Appellees.

James Constant, of Claremont, California, submitted Pro Se.

Jerry R. Selinger, Baker, Mills & Glast, of Dallas, Texas, submitted for defendants-appellees, Texas Instruments, Inc. Adrian M. Pruetz, Morrison & Foerster, of Los Angeles, California, submitted for defendants-appellees, Fujitsu, Ltd. and Fujitsu

Microelectronics, Inc. Martin R. Horn, David M. Simon and David A. Hall, Spensley Horn Jubas & Lubitz, of Los Angeles, California, submitted for defendants-appellees, Hitachi America, Ltd. Edwin H. Taylor and James C. Scheller, Jr., Blakely Sokoloff, Taylor & Zafman, of Sunnyvale, California, submitted for defendants-appellees Advanced Micro-Devices, Inc. Intel Corporation.

Appealed from: U.S. District Court for the Central District of California

Judge Wilson

UNITED STATES COURT OF APPEALS

FOR THE FEDERAL CIRCUIT

88-1101

JAMES CONSTANT,

Plaintiff-Appellant,

v.

ADVANCED MICRO-DEVICES, INC., GOULD, INC., AMERICAN MICROSYSTEMS, INC., ANALOG DEVICES, INC., FUJITSU, LTD., FUJITSU MICROELECTRONICS, INC., DIGITAL SWITCH, INC., GRANGER ASSOCIATES, INC., HITACHI CORPORATION, INTEL, INC., INTERACTIVE CIRCUITS & SYS., LTD., MATSUSHITA ELECTRONICS CORP., COMPUTER MODULES, INC., NIPPON ELECTRIC CO., LTD., NEC ELECTRONICS USA, PARADYNE CORPORATION, SEMICONDUCTOR PRODUCTS, TEXAS INSTRUMENTS, INC. and TRW, INC.,

Defendants-Appellees.

DECIDED: June 9, 1988

Before DAVIS, Circuit Judge, COWEN, Senior Circuit Judge, and SMITH Circuit Judge.

DAVIS, Circuit Judge.

Appellant Constant has raised a large number of separate and diverse issues on appeal. The appealed decisions and ruling of the United States District Court for the Central District of California are all affirmed.

DISCUSSION

In January 1985, appellant James Constant sued a large group of high technology companies for infringements of his United States Patents Nos., 3,950,635 (the '635 patent) and 4,438,491 (the '491 patent). The complaint also contained nine counts involving other theories of recovery and included challenges to the constitutionality of 35 U.S.C. § 282 and of federal funding of research and

development. The district court (Hon. Pamela A Rymer) dismissed all counts except the infringement claim (Count V) for failure to state claims upon which relief could be granted, and later denied several motions by Constant attempting to revive the dismissed claims.

The defendants filed counterclaims for declaratory relief asking to have the patents declared invalid, unenforceable and not infringed. The case was transferred to the Hon. Steven V. Wilson on December 16, 1985. In August 1986, Judge Wilson, with the agreement of all parties, appointed a Special Master, Robert E. Hillman, to make recommendations to the court concerning motions for summary

judgment on issues of patent invalidity. After the special master issued recommendations concluding that the patents are invalid, Constant moved to disqualify the special master and to strike his report. The court ruled against these motions after hearings during which Constant was given a special opportunity to question the master. The court independently determined that there were no material issues of contested facts and entered a summary judgment declaring the claims of the two patents to be invalid under 35 U.S.C. §§ 102(b) and 103.

Constant now appeals the judgments of invalidity, the dismissal of his constitutional claims, the appropriateness of a summary judgment,

the role and conduct of the special master, and several procedural rulings of the district court. Because of appellant's earnest efforts to support his positions, we deal with them in greater detail than their merits deserve.

I. Constitutional Issues

Appellant challenges the constitutionality of 35 U.S.C. § 282, which (among other things permits the federal courts to adjudicate the validity of patents when invalidity is raised as an affirmative defense in infringement suits [1].[1] His argument is based on the wording of the Patent and Copyright Clause of the

[1] Numbers in brackets refer to appellant's listing of the issues on appeal, as enumerated in Brief for Appellant, pp. 8-10.

Constitution, U.S. Const. art. I, § 8, cl. 8, which states that Congress shall have the power to "promote the Progress of ... useful Arts, by securing for limited Times to ... Inventors the exclusive Right to their ... Discoveries." Appellant construes the word "securing" to require that a patent issued by the Patent and Trademark Office (PTO) must be "secure," i.e. conclusively valid and unchallengeable.

This novel interpretation is obviously erroneous. Since the adoption of the first Patent Act in 1790, Congress has permitted judicial

review of the validity of patents.[2] The courts, the interpreters of the meaning of the Constitution, have consistently construed the Patent and Copyright Clause to permit judicial review of patents. See Graham v. John Deere Co., 383 U.S. 1, 8-10, 148 USPQ 459, 462-64 (1966); Slawson v. Grand Street R.R. 107 U.S. 649, 652 (1882); Mast, Foos & Co. v. Stover Mfg. Co., 177 U.S. 485,488-89 (1900). Public policy requires that only inventions

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[2] Judicial review of patent validity was accepted by members of Congress and presidents who were themselves framers of the Constitution. This is strong evidence that they did not intend patents to be unchallengeable in the courts. Cf., Burrow-Giles Lithographic Co. v. Sarony, 111 U.S. 53, 56-57 (1884) (Early acts of Congress are evidence of original intent of framers concerning the meaning of the term "writings" in art. I, § 8, cl. 8.).

which fully meet the statutory standards are entitled to patents. This policy is furthered when the validity of a patent, which was originally obtained in ex parte proceedings in the PTO, can be challenged in court. Lear, Inc. v. Adkins, 395 U.S. 653, 670, 162 USPQ 1, 8 (1969).

"Within the limits of the constitutional grant, the Congress may ... implement the stated purpose of the Framers by selecting the policy which in its judgment best effectuates the constitutional aim." Graham, 383 U.S. at 6, 148 USPQ at 462. Accord United States v. Dubilier Condenser Corp., 289 U.S. 178, 189, 17 USPQ 154, 158 (1933). Thus, Congress has broad discretion on how to implement the

conditions and tests for patentability. Id.; McClurg v. Kingsland, 42 U.S. (1 How.) 202, 206 (1843). Nowhere does the Constitution require that the determination of patent validity be vested solely in the PTO (or even that there be a PTO). Congress was fully within its constitutional power when it delegated power to the courts in 35 U.S.C. § 282 to adjudicate the validity of patents in infringement suits.[3] Congress was also within its constitutional powers

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[3] Similarly, Congress has the power to delegate to the courts the power to review decisions of the PTO under 35 U.S.C. §§ 141-145, so that the courts may declare an invention to be patentable after it has been rejected by the PTO. Appellant has appealed decisions of the PTO under 35 U.S.C. § 141, thus recognizing the power of the courts to review decisions of the PTO.

when it created a reexamination procedure as an additional mechanism for the review of patents. The creation of reexamination did not divest the courts of any power to review patent validity. See 35 U.S.C. § 306; Patlex Corp. v. Mossinghoff, 758 F.2d 594, 601-02 225 USPQ 243, 248-50 (Fed. Cir. 1985); In re Etter, 756 F.2d 852, 857-58, 225 USPQ 1, 3-4 (Fed. Cir. 1985). The district court thus had jurisdiction to review the validity of the '635 and '491 patents.

Appellant also argues that Government sponsorship of research and development is unconstitutional [5]. He objects particularly to Government sponsorship of the research reported in an article by Allen and Westerfield which was found to be prior art

against his patents. He advances two constitutional arguments. First, he argues that Government sponsorship of research and development offends the "Science Clause"[4] of the Constitution, which he construes to mean that the only constitutionally permissible means for the Government to promote science is by securing the rights of inventors and authors. This

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[4] The full text of art. I, § 8, cl. 8 is: "[The Congress shall have Power] ... To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." The power to grant patents to inventors is for the promotion of the useful arts, while the power to grant copyrights to authors is for the promotion of "Science," which had a much broader meaning in the 18th Century than it does today. In re Bergy, 596 F.2d 952, 958, 201 USPQ 352, 359 (CCPA 1979), aff'd sub nom. Diamond v. Chakrabarty, 447 U.S. 303, 206 USPQ 193 (1980).

interpretation is likewise erroneous. Art. I, § 8, cl. 8 does not state that the Government may promote the progress of the useful arts only through the patent and copyright system. Ample constitutional power for Government funding of research and development can be found in art. I, § 8, cl. 1 (provide for the common Defense and general Welfare), cl. 3 (Commerce), cl. 12 (Army), cl. 13 (Navy) and cl. 18 (necessary and proper clause). It is also settled that art. I., § 8 authorizes Congress to spend money to promote the "general welfare," and that the definition of the general welfare and decisions concerning how to promote it are within the discretion of Congress. Helvering v. Davis, 301 U.S. 619, 640

(1937); Buckley v. Valeo, 424 U.S. 1, 90-91 (1976). Government support for research and development is well within this discretionary power.

Appellant charges that he has been deprived of liberty and property without due process in violation of his 5th and 14th amendment rights in several contexts [5, 7, 10, 11]. He fails to point to any legally recognized liberty interest of which he has been deprived. The court below has invalidated his patent property interest, but the legal proceedings in which he participated fully provided the constitutionally required degree of due process. There may be debate as to the full meaning of "due process," and the courts have struggled to define its boundaries and

requirements within the context of nonjudicial governmental action. E.g., Mathews v. Eldridge, 424 U.S. 319 (1976). However, it is unambiguously clear that federal judicial proceedings, with their extensive notice, opportunity to be heard, and procedural protections, satisfy the constitutional requirement of procedural due process required for the invalidation of a patent. Constant has failed to demonstrate any legally cognizable deprivation of due process. On the contrary, the district court went to great lengths to give his claims a full and fair hearing.

Appellant tried to reargue these constitutional arguments in his motions for declaratory judgment [11].

The district court properly dismissed these motions for procedural defects. Plaintiff should understand that, had these motions been considered on the merits, he would have lost for the reasons stated this opinion.

II. Dismissal of Noninfringement Claims

The district court dismissed Counts I-IV and VI-X for failure to state a claim upon which relief can be granted, pursuant to Fed. R. Civ. P. 12(b)(6) [10]. These counts alleged a variety of causes of action including deprivation of civil rights, constitutional rights, and antitrust violations. The dismissals were correct on several grounds. A dismissal for failure to state a claim is proper where it appears beyond

doubt that plaintiff can prove no set of facts which would entitle him to relief. Conley v. Gibson, 355 U.S. 41, 45-46 (1957); Stanspec Co. v. American Chain & Cable Co., 531 F.2d 563, 566, 189 USPQ 420, 422 (CCPA 1976). Appellant's objections appear to center mainly on his assertions that he can and is entitled to prove the facts asserted in the complaint. However, the court found that those facts, even if true, would not entitle appellant to relief from the court. The court determined that each of his claims lacks some element that would be necessary to entitle him to legal relief. We have considered the reasoning for the dismissal of each count set forth the Tentative Ruling appended to the court's order of July

2, 1985, and see no legal error.

There are also numerous additional legal grounds supporting dismissal. For example, appellant cites United Brotherhood of Carpenters v. Scott, 463 U.S. 825 (1983), to argue that his Count II ("Civil Rights/ Patent Law") meets the criteria for a cause of action under 42 U.S.C. § 1985(3) ("Conspiracy to interfere with civil rights"). On the contrary, the holding in that case is that conspiracies based on economic or commercial animus, like those which appellant alleges, are beyond the reach of § 1985(3). Id. at 839. The district court correctly noted that appellant also failed to establish the requisite state action or class-based discriminatory animus.

In addition to the defects requiring the dismissal of individual counts, appellant has conceded that each of the nine dismissed counts depends inextricably on his theories concerning the unconstitutionality of 35 U.S.C. § 282 and of federal support for research and development. Since these constitutional theories are without merit, appellant could not prevail on any cause of action that depends upon them even if the facts stated in the complain were true. Thus, dismissal of the nine counts under Rule 12(b)(6) was warranted.

III. The Special Master

Appellant argues that the use of a special master deprived him of his right to a jury trial [2]. He also challenges the qualifications of the

special master and charges that the latter "suppressed" and misinterpreted evidence [3]. Constant contends that the district court erred in refusing to grant his motions to disqualify the master and strike the master's recommendations.

The federal courts have the inherent power to appoint persons unconnected with the court to aid judges in the performance of specific duties. Ex parte Peterson, 253 U.S. 300, 312 (1920). See Ruiz v. Estelle, 679 F.2d 1115, 1161 n.240 (5th Cir. 1982). Although here the parties agreed to the appointment of a master, the court has the power to appoint masters without the consent of the parties. Peterson, 253 U.S. at 312-14. Reference of issues to a master,

even compulsory reference, does not violate the 7th Amendment right to trial by a jury to which a master's findings may be read under Rule 53(e)(3). Crateo, Inc. v. Intermark, Inc., 536 F.2d 862, 868 (9th Cir.), cert. denied, 429 U.S. 896 (1976); Peterson, 253 U.S. at 309-12. Masters can properly aid the court in evaluating issues of patent validity and infringement in the context of motions for summary judgment, and have often done so. Milliken Research Corp. v. Dan River, Inc., 739 F.2d 587, 222 USPQ 571 (Fed Cir. 1984); D. L. Auld Co. v. Chroma Graphics Corp., 714 F.2d 1144, 219 USPQ 13 (Fed. Cir. 1983). See Williams & Thierstein, Use of Masters in Litigation, 12 AIPLA Q.J. 227, 237-43 (1984).

The powers and conduct of special masters are generally governed by Fed. R. Civ. P. 53, and the specific powers of the master are defined by the order of reference in each particular case. Rule 53(c). Judge Wilson's order of May 16, 1986 empowered the master to review the submissions of the parties, hold hearings and make recommendations on the motions for summary judgment as to the issues of invalidity and noninfringement that were before the court. All actions of the master were properly within the limits of that order of reference.

Appellant agreed to the appointment of the master and participated in hearings and presentation of evidence to the master. It was only after the master

issued recommendations unfavorable to the appellant that the latter objected to the use of the master. A party cannot wait to see whether he likes a master's findings before challenging the use of a master. Failure to object in a timely fashion constitutes a waiver. Spaulding v. Univ. of Wash., 740 F.2d 686,, 695 (9th Cir. 1984); Hill v. Duriron Co., 656 F.2d 1208, 1213 (6th Cir. 1981); Hayes v. Foodmaker, Inc., 634 F.2d 802 (5th Cir. 1981). There was no Abuse of discretion in the district court's denial of appellant's motion to disqualify the master. Macri v. United States, 353 F.2d 804 (9th Cir. 1965). The court also acted within its discretion in refusing to allow the appellant to attack the

qualifications of the master during a special hearing that was held to allow the appellant to question the master on the merits of the recommendations.

We also note that from the record Mr. Hillman appears to be very well qualified to serve as a master in this case. Appellant Constant is wrong in presuming that a master need have the same expertise in the technology as the inventor. Where complicated issues of patent law are involved, the appointment of an experienced patent attorney is quite appropriate. The charges that the master misinterpreted and suppressed evidence are wholly unjustified.

IV. Summary Judgment

Appellant complains that the summary judgment against him

impermissibly shifted the burden of proof by requiring him to come forward during discovery with evidence of validity [8], thus depriving him of the procedural advantage that derives from the presumption of validity in 35 U.S.C. § 282. Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983). On the contrary, appellees met their burden of proceeding first and their burden of persuasion in connection with their motions for summary judgment. Appellees were entitled to use of discovery of the appellant in support of their motion for summary judgment, and this did not shift the burden of first-proceeding to Constant.

Appellant failed to create a summary judgment record that raised

any genuine issue of material fact that would render summary judgment inappropriate. Hodosh v. Block Drug Co., 786 F.2d 1136, 1141, 229 USPQ 182, 186 (Fed. Cir.), cert. denied, 107 S. Ct. 106 (1986). Matsushita Elec. Indus. Co. v. Zenith Radio Corp., 475 U.S. 574, 585-87 (1986); Chore-Time Equip., Inc. v. Cumberland Corp., 713 F.2d 774, 778, 218 USPQ 673, 675 (Fed. Cir. 1983). It is established that there is no right to a jury trial where there are no issues of fact to be tried by the jury, and that a proper summary judgment does not violate the 7th Amendment. Poller v. Columbia Broadcasting Sys. Inc., 368 U.S. 464 (1962); Fidelity & Deposit Co. of Md. v. United States, 187 U.S. 315, 320 (1902); Peterson,

253 U.S. at 310.

V. Validity of the '491 Patent

The purpose of the invention in the '491 patent is to provide integrated circuit chips that can be interconnected in a computer with fewer wires (leads). The wires that interconnect chips must be attached at bonding pads, which are metallic areas on the chip that take up a relatively large amount of space that might otherwise be used for logic circuitry. The invention is based on eliminating some prior art pads and leads and using the areas vacated to incorporate on-chip means for transmitting and receiving signals (transceivers). For example, the patent states that the receiver means can be implemented on the ship as a analog-to-digital (A/D)

converter and that the transmitter means can be implemented on the chip as a digital-to-analog (D/A) converter. The interconnections between ships may then be reduced because a single analog voltage on a single wire can represent the same value that would require several wires to transmit in digital form as binary 0's and 1's.

The '491 patent contains thirty claims. Many of the claims differ from others only in using different kinds of transceivers instead of A/D converters (e.g. modems, light emitting diode/photodetector) or in using different means instead of wires for interconnecting the chips (e.g., optical, acoustical, electromagnetic). These transceiver and interconnecting

means are all in the prior art, as are the monolithic (i.e., on a single chip) integrated circuits used in the invention. The claimed novel invention is the use of transmitter and receiver means on a chip in order to transform incoming and outgoing signals so as to reduce the number of pads on a chip and the number of interconnecting leads between chips.

Appellant sued appellee Intel Corporation (Intel) charging that Intel's 2920 IC chip infringed the '491 patent.[5] The 2920 is a single

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[5] Constant wrote Intel stating that the 2920 Signal Processor infringed claims 1, 7, 8, 9, 16, 18, and 23 of the '491 patent and demanding that Intel take a licence. It is these claims, plus claims 21 and 22, that were later found to be invalid because of anticipation by the allegedly infringing 2920 chip and its related publications.

chip microcomputer in which an on-chip A/D converter converts an incoming analog signal into digital form, processes the digital data using programmable on-chip digital processors and then transforms it into a analog output signal through an on-chip D/A converter. (The 2920 also has additional capabilities such as a sample-and-hold circuits for the input and output.)

Appellant filed his application for the '491 patent with the PTO on October 14, 1980. Therefore the critical date, for purposes of a 35 U.S.C. § 102(b) (statutory bar via prior description, use, or being on sale), is October 14, 1979. There is uncontroverted evidence, and Constant has conceded, that the 2920 was on

sale before the critical date. Intel moved for a summary judgment on the basis that these earlier sales anticipate and invalidate the asserted claims under § 102(b).

Constant apparently conceded that the 2920 embodied the other elements of the claims in the patent, but defended that the preamble of the claims was not anticipated by the 2920. The preamble of claims 1, 18, and 23 through 28 is in Jepson format, and reads: "In a computer with monolithic IC chips interconnected for data transfers, the improvement to reduce the number of interconnections between chips including: [remaining claim elements]." Constant's argument was that sales of the 2920 before the critical date did not anticipate the

claimed invention since the chips were not sold interconnected with other chips in a computer.

Intel responded that the Jepson format preamble should not be considered to be part of the claims, and that sale of the 2920 chips alone was anticipatory. Intel also submitted publications about the 2920 that had been distributed to the public before the critical date -- arguing that these publications anticipated all of the involved '491 claims including the preamble. The district court decided, for purposes of the motion for summary judgment, to resolve all doubts in favor of Constant and to assume that anticipation of the preamble was necessary and that the sale of 2920

chips alone did not anticipate the preamble. The court therefore examined the publications to determine whether they fully anticipated the claims in issue including the preamble. The court also considered, in light of the materials submitted, whether the claims in issue or any of the remaining claims in the patent would have been obvious under 35 U.S.C. § 103. The special master was appointed to assist the court in reviewing submissions and to issue recommendations on these questions.

The court held that certain publications submitted by Intel fully anticipated all elements of claims 1,7,8,9,16,18,21,22, and 23 of the '491 patent, including the preamble, and that those claims were therefore

invalid under 35 U.S.C. § 102(b). The court determined that all remaining claims of the '491 patent, which involved substitution of different transceiver or interconnection means, would have been obvious to one having ordinary skill in the art, and were thus invalid under 35 U.S.C. § 103.

The court found that the claims 1, 7, 8, 9, 16, 18, 21, 22 and 23 (including their preambles) were fully anticipated by Exhibit 5, which is a specification sheet for the 2920 that was distributed to the public by Intel in September 1979. Appellant argues that Exhibit 5 was not a printed publication for purposes of the § 102(b) bar [4] because there is no evidence in the record to prove that it was actually received by the public

before October 14, 1979. The statutory phrase "printed publication" has been interpreted to mean that before the critical date the reference must have been sufficiently accessible to the public interested in the art; dissemination and public accessibility are the keys to the legal determination whether a prior art reference was "published." In re Hall, 781 F.2d 897, 899, 228 USPQ 453, 455 (Fed. Cir. 1986); In re Wyer, 655 F.2d 221, 225-27, 210 USPQ 790, 794-95 (CCPA 1981). Intel presented extensive uncontroverted evidence of business practice that was sufficient to prove that Exhibit 5 was widely available and accessible to the interested public before October 14, 1979. Evidence of routine business

practice can be sufficient to prove that a reference was made accessible before a critical date. In re Hall, 781 F.2d at 899, 228 USPQ at 455. Accessibility goes to the issue of whether interested members of the relevant public could obtain the information if they wanted to. If accessibility is proved, there is no requirement to show that particular members of the public actually received the information.

A printed publication must also be enabling. In re Donohue, 766 F.2d 531, 533, 226 USPQ 619, 621 (Fed. Cir. 1985) Constant argues that Exhibit 5 was not enabling [4] because it does not describe a computer program to make the 2920 operational. He contends that in 1979 the 2920 was a

novel, sophisticated chip which required a new hardware and software package to program, and argues that one having only ordinary skill in the art would not be able to program and use the 2920. However, Intel has presented uncontroverted evidence that the SP20 kit for programming the 2920 ship was available to the public and on sale before the critical date. Moreover, specific computer programs are irrelevant to the claimed invention. The specification of the '491 patent does not disclose any specific computer programs and does not suggest that a computer program is part of the invention. Such programs are not elements of the claims of the '491 patent. The claims all concern hardware configurations. The

disclosure in Exhibit 5 is at least at the same level of technical detail as the disclosure in the '491 patent. If disclosure of a computer program is essential for an anticipating reference, then the disclosure in the '491 patent would fail to satisfy the enablement requirement of 35 U.S.C. § 112, First paragraph.

Constant also argues that Exhibit 5 fails explicitly to disclose a reduction in the number of interconnections between chips, as required by the preamble of the claims. The district court found that reduction in the number of interconnections is inherent in the descriptions of applications for the 2920 described in Exhibit 5. In sum, there was no error in the district

court's conclusion that Exhibit 5 was an enabling printed publication.

The court concluded that all remaining claims of the '491 patent would have been obvious to one having ordinary skill in the art under 35 U.S.C. § 103. In analyzing obviousness, the court considered the factors required by Graham. See Custom Accessories, Inc. v. Jeffrey-Allan Indus. Ind., 807 F.2d 955, 958 1 USPQ 2d 1196, 1197 (Fed. Cir. 1986). The court relied on the publications submitted by Intel and also on Constant's own statements submitted to the PTO during prosecution, to the effect that all of the substitutions "can be made without undue experimentation by the routineer" with the help of prior art references that

he cited. Constant's main argument is that because the 2920 was so novel and sophisticated, the level of skill needed to program it and to substitute transceiver and interface means was so high that it was beyond the ordinary skill in the art. However, Constant's own admission during prosecution that this could be accomplished by the routineer is strong evidence to the contrary, and is binding upon him. The district court's findings were not erroneous, and the conclusion that the remaining claims would have been obvious is not incorrect.

VI. Validity of the '635 Patent

The '635 patent describes a digital signal processor for comparing two electrical signals, either as a correlator (where both signals are

changing) or as a matched filter (where one of the signals is a fixed reference signal stored in a memory device). Correlators and matched filters that used shift registers to store the input and reference signals were known in the prior art. Appellant's invention uses random access memory (RAM) devices instead of shift registers to store the input and reference signals. Appellant conceded in the specification of the '635 patent that everything described in the patent was prior art technology except the use of RAMs (with the required associated circuitry for addressing the memory) instead of shift registers. A statement in a patent that something is in the prior art is binding on the applicant and

patentee for determinations of anticipation and obviousness. In re Nomiya, 509 F.2d 566, 571n.5 [sic], 184 USPQ 607, 611 n.4 (CCPA 1975).

Constant filed an application for the '635 patent on June 17, 1974, and the patent issued on April 13, 1976. Prior art publications submitted by the appellees included and article by Allen and Westerfield published in 1964 and U.S. Patent No. 3,295,107 issued in 1966 (the Stalcup patent). The court found that each of these references individually disclosed all of the elements in claims 1, 2, 6, 8, 9, and 11-14 of the '635 patent, and that the Allen and Westerfield article also disclosed each and every element of claim 7. These claims were therefore held to be invalid under 35

U.S.C. § 102(b).

The court also examined whether any claims of the '635 patent would have been obvious under 35 U.S.C. § 103. An article published by Springer in September 1973, suggested using RAMs in place of shift registers in a variety of applications. The Springer article falls short of disclosing the subject matter of claim 1 only in that, while it recommends the general substitution of a RAM for a shift register, it does not specifically disclose a correlator or matched filter. Constant admitted that he read the Springer article, and that it taught him to substitute RAMs for shift registers and led him to conceive the inventions in the '635 patent.

The district court examined the factual considerations required by Graham, 383 U.S. at 17-18, 148 USPQ at 467 based on undisputed material facts. The scope and content of the prior art and the differences between the claims at issue and the prior art were ascertained using the submitted documents. Judge Wilson accepted Constant's own statement that the level of ordinary skill in the art would be an individual having a Ph.D. in electrical engineering or physics. The court concluded that there was no objective evidence of nonobviousness sufficient to create a genuine issue of material fact. Sweats Fahions, Inc. v. Pannill Knitting Co., 833 F.2d 1560, 1562-63, 4 USPQ 2d 1793, 1795-96 (Fed. Cir. 1987). The court then

considered the claimed invention as a whole and found that all of the claims in the '635 patent would have been obvious to one having that level of skill in the art -- considering the Springer article, the Allen and Westerfield article, and the Stalcup patent. The court ruled that obviousness had been established by clear and convincing evidence sufficient to overcome the presumption of validity attaching to a patent under 35 U.S.C. § 282.

Appellant raises a variety of objections concerning the invalidation of the '635 patent [4]. His argument that the publications are not prior art borders on the frivolous, since the Allen and Westerfield article and the Stalcup were published about eight

years before Constant applied for his patent, and Constant has admitted that he read the Springer article before conceiving the invention. Appellant also argues that the anticipating references lack various elements of his claimed invention. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Kalman v. Kimberly Clark Corp., 713 F.2d 760, 771 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 456 U.S. 1026 (1984). Constant points to a number of features of his invention which he says are not found in the anticipating references. For example, he argues that the random access memory in the claims was

defined and must be understood to be a "semiconductor RAM with log2n address lines connecting the RAM through a decoder." The Allen and Westerfield article and Stalcup patent both use magnetic core memories instead of semiconductors. The court found that magnetic core memory is a type of RAM. The limitations on which the appellant relies (i.e., semiconductor, log2n address lines, connection through a decoder) are not stated in the claims. Other limitations that he tries to read from the specifications into the claims are also absent from the claims (with the exception of the multiplier, discussed below). It is the claims that define the claimed invention. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1053, 5 USPQ2d 1434,

1440 (Fed. Cir. 1988). And it is claims, not specification, that are anticipated. Although the embodiments in the specification involve semiconductor RAMs and log2n address lines, these limitations are not found anywhere in the claims. Appellant is apparently invoking his rights as an inventor to be his own lexicographer, arguing that he defined random access memory in the specification in a way that requires these limitations to be read into the term. Although a patentee may be his own lexicographer, the patent specification must support his asserted definition. Fonar Corp. v. Johnson & Johnson, 821 F.2d 627, 632, 3 USPQ2d 1109, 1113 (Fed. Cir. 1987), cert. denied, 108 S. Ct. 751 (1988). Constant did not explicitly

define terms anywhere in the specification in ways that support his current assertions. The text does not implicitly suggest that the words should be interpreted to convey the restricted interpretation that he now asserts. Rather, the patent states that the random access memory "may be any one of a number of types, the exact type to be determined by the application." Col. 4, lines 15-17.

Appellant misinterprets the principle that claims are interpreted in the light of the specification. Loctite Corp. v. Ultraseal Ltd., 781 F.2d 861, 867, 228 USPQ 90, 93 (Fed. Cir. 1985). Although the specification may aid the court in interpreting the meaning of disputed language in the claims, particular

embodiments and examples appearing in the specification will not generally be read into the claims. Id.; SRI Int'l v. Matsushita Elec. Corp. of Am., 775 F.2d 1107, 1121, 227 USPQ 577, 585 (Fed. Cir. 1985) (in banc); D.M.I., Inc. v. Deere & Co., 755 F.2d 1570, 1574, 225 USPQ 236, 239 (Fed. Cir. 1985); Fromson v. Advance Offset Plate, Inc., 720 F.2d 1565, 1568, 219 USPQ 1137, 1139 (Fed. Cir. 1983); Arshal v. United States, 621 F.2d 421, 428, 208 USPQ 397, 404 (Ct. Cl. 1980). Constant's asserted limitations concerning semiconductor RAMs and log2n address lines should not be read into the claims. His similar arguments concerning storing of words in a single location in memory, connection of elements as disclosed in

the figures and pulse compression also fail for similar reasons. Although these elements are found as examples or embodiments in the specifications, they were not claimed explicitly. Nor were the words that are used in the claims defined in the specification to require these limitations. A reading of the specification provides no evidence to indicate that these limitations must be imported into the claims to give meaning to disputed terms.

All of the claims do specify "multiplier means." Constant argues that this element is lacking in the references, which disclose only exclusinve-OR gates. However, an exclusive-OR gate is a type of multiplier, and the embodiment of the

invention disclosed in the specification explicitly shows and exclusive-OR gate used as a multiplier for comparison of signals in his invention. 35 U.S.C. § 112, Sixth Paragraph, provides that means-plus-function language in a claim shall be construed to cover the structure described in the specification and equivalents therof. Thus, "multiplier means" must be construed to cover the exclusive-OR gates in Allen and Westerfield, and the comparator in the Stalcup patent can reasonably be classified an equivalent therof. There is no error in the district court's decision that the specified claims were anticipated and are therefore invalid.

In objecting to the finding of

the obviousness of all claims, appellant protests that the court did not consider the prior art that was before the examiner in the Patent Office and complains that the anticipating references have not been shown to be more pertinent than the prior art that was considered by the examiner. There is no legal authority for the view that the court must first determine that prior art in an evaluation of obviousness is more pertinent than the prior art considered by the PTO.[6] It is, of

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[6] This notion appears to have been borrowed from the case law on the duty of candor before the PTO, where a patentee is obligated to call to the attention of the PTO references more pertinent than those already known to the examiner. Any relevant evidence, whether more or less pertinent, can be considered in an analysis of obviousness.

course, self-evident that any reference that fully anticipates claims of the patent or that was the source of ideas used by the inventor when he conceived his invention is relevant and can be considered on the issue of obviousness. If an invention would have been obvious in the light of certain prior art references, it is irrelevant that it would not have been obvious from other references.

Appellant protests that the court failed to consider objective indicia of nonobviousness as required by Graham, which must always be considered when available. Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d at 1538, 218 USPQ at 879. However, most of his purported evidence consisted only of argument

and conclusory statements rather than factual evidence. Thus he has failed to meet his burden to produce specific facts showing that on this issue there is a genuine issue of material fact for trial. Fed. R. Civ. P. 56(e). See Sweats Fashions, 833 F.2d at 1562-63, 4 USPQ2d 1793 at 1795-96. Obviousness is a question of law based on factual inquiries. Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1568, 1 USPQ2d 1593, 1597 (Fed. Cir.), cert. denied, 107 S. Ct. 2187 (1987); Loctite, 781 F.2d at 872, 228 USPQ at 97. This court can thus review a determination of obviousness for legal error. Even if we were to give the appellant the benefit of the doubt concerning his asserted objective indicia of non-obviousness, in the

context of this motion for summary judgment, we would find no error. Appellees have established a strong prima facie case of obviousness that would not be overcome by the particular objective considerations advanced by the appellant. Thus, Constant's purported objective evidence of nonobviousness does not pose a genuine issue of material fact that would preclude summary judgment. Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 248 (1986).

VII. Other Issues

Appellant has raised other issues on appeal concerning rulings of the district court on evidentiary matters [7], discovery and joinder [9]. We have examined the rulings of the district court on these matters and

find no legal error. In addition, if there had been any legal errors in these rulings, they would have been harmless errors that would not justify reversal. 28 U.S.C. § 2111.

Appellant has had an extensive opportunity to litigate his claims. The district court went to great lenghts to be fair and has shown great patience in the face of arguments and tactics that would have been improper if advanced by a lawyer. Two federal courts have now fully and fairly considered appellant's claims and determined that the '491 and '635 patents are invalid and that his various other claims are without merit. In the past the appellant has repeatedly attempted to reassert or revive claims and theories after they

have been properly dismissed with prejudice by the district court. Appellant is hereby cautioned that if he persists by trying to raise again the same issues that have been finally decided by the district court or by this court, he could be sanctioned under Fed. R. Civ. P. 11, Fed. R. App. P. 38, and the inherent power of the courts to sanction. Alyeska Pipeline Serv. Co. v. Wilderness Soc., 421 U.S. 240, 258-59 (1975); see Urban v. United Nations, 768 F.2d 1497 (D.C. Cir. 1985).

AFFIRMED.

Note: This Order has not been prepared for publication in a printed volume because it does not add significantly to the body of law and is not of widespread legal interest. It is a public record. It is not citable as precedent.

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

88-1101

JAMES CONSTANT,

Plaintiff-Appellant,

v.

ADVANCED MICRO-DEVICES, INC., GOULD, INC., AMERICAN MICROSYSTEMS, INC., ANALOG DEVICES, INC., FUJITSU, LTD., FUJITSU MICROELECTRONICS, INC., DIGITAL SWITCH, INC., GRANGER ASSOCIATES, INC. HITACHI CORPORATION, INTEL, INC., INTERACTIVE CIRCUITS & SYS, LTD., MATSUSHITA ELECTRONICS CORP., COMPUTER MODULES, INC., NIPPON ELECTRIC CO., LTD., NEC ELECTRONICS USA, PARADYNE CORPORATION, SEMICONDUCTOR PRODUCTS, TEXAS INSTRUMENTS, INC., and TRW, INC.,

Defendants-Appellees.

Before COWEN, Senior Circuit Judge, and
SMITH, Circuit Judge.

O R D E R

A petition for rehearing having been filed in this case, UPON CONSIDERATION THEREOF, it is ORDERED that the petition for rehearing be, and the same hereby is, denied.

FOR THE COURT:
Francis X. Gindhart,
Clerk

Date: 7/8/88

cc: Mr. James Constant, Mr. Jerry R. Selinger, Mr. Allen M. Katz, Mr. Edwin H. Taylor, Mr. Adrian M. Pruetz, Mr. Howard P. Brody, Mr. Martin R. Horn, and Mr. Joseph C. Sullivan.

FILED
U.S. COURT OF APPEALS FOR
THE FEDERAL CIRCUIT
July 8, 1988
FRANCIS X. GINDHART
CLERK

CERTIFICATE OF SERVICE

I certify that the foregoing

APPENDIX A

was served on all parties on

17 August, 1988

by mailing first class a true and correct copy thereof to them addressed as follows:

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Supreme Court, U.S.
FILED
AUG 10 1988
JOSEPH F. SPANIOL, JR.
CLERK

No. 88-308

IN THE

SUPREME COURT OF THE UNITED STATES

TERM 1988 - 1989

JAMES N. CONSTANT,

Petitioner

v.

ADVANCED MICRO-DEVICES, INC., et al.,

Respondents *

APPENDIX B

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

James Constant
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Pro se petitioner

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* see APPENDIX A for a complete list of all Respondents

APPENDIX B

Contents

Page

Judgment District Court B-2

Proposed Findings of Fact and

Consclusions of Law:

'635 Patent B-3

'491 Patent B-35

Order District Court Granting Costs

to Respondents B-65

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA
CASE NO. 85-0262-SVW
JUDGMENT
JAMES CONSTANT,
Plaintiff,
vs.
ADVANCED MICRO-DEVICES, INC., et al.,
Defendants.

The Court hereby enters judgment in accordance with the findings of facts and conclusions of law entered by the Court on October 28, 1987. Accordingly, the Court hereby enters its judgment finding invalid United States Patents numbered 3,950,635 and 4,438,491.

IT IS SO ENTERED.

DATED: November 6, 1987

STEPHEN V. WILSON

UNITED STATES DISTRICT JUDGE

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UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA
Civil Action No.CV 85-0262 SVW (Bx)
PROPOSED FINDINGS OF FACT AND CONCLUSIONS OF LAW RE: SUMMARY JUDGMENT OF INVALIDITY OF U.S. PATENT NO. 3,950,635.

JAMES CONSTANT,
Plaintiff,

v.

ADVANCED MICRO-DEVICES, INC., et al.,
Defendants.

Pursuant to this Court's Order at the May 4, 1987 hearing, defendant HITACHI AMERICA, LTD. ("HAL") submits the following proposed findings of fact and conclusions of law following this Court's granting of the HAL Motion for Summary Judgment of Invalidity of U.S.

Patent No. 3,950,635.

FINDINGS OF FACT

A. The Parties to the Motions and the Causes of Action

1. Plaintiff James Constant ("Constant") is an individual residing in Claremont, California. Constant has charged each of the defendants in this action with infringement of U.S. Patent No. 3,950,635 (the "'635 patent") and 4,438,491 (the "'491 patent).

2. This is a case of alleged patent infringement. All of the causes of action unrelated to patent infringement were dismissed with prejudice by order of the Honorable Pamela Ann Rymer on July 11, 1985.

3. Jurisdiction over defendants is predicated under the patent laws of the United States, 35 U.S.C. §§ 1, et

seq., pursuant to 28 U.S.C. § 1338 (a) and (b), and on other grounds related to the dismissed causes of action. (Complaint at paragraph 1).

4. Defendant HAL brought a motion for Summary Judgment of Invalidity of U.S. Patent No. 3,950,635. Defendant Intel brought a motion for Summary Judgment of Invalidity of the '491 patent.

5. Following a hearing and pursuant to agreement of the parties, this Court appointed Robert E. Hillman to act as a Special Master in this action pursuant to Rule 53 of the Federal Rules of Civil Procedure. (Order of Reference filed August 4, 1986).

6. Mr. Hillman is qualified to perform as a Special Master, having

practiced patent law for the last twenty-five years with extensive experience in patent prosecution and litigation, having an undergraduate degree from the Massachusetts Institute of Technology in physics and mathematics and a law degree from the Harvard Law School. (Defendant's Opposition to Plaintiff's Motion to Disqualify the Master and to Strike his Report to the Court at 4-5; letter from Paul S. Malingagio to Honorable Stephen V. Wilson dated July 31, 1986) (enclosing letter and resume from Robert E. Hillman).

7. Pursuant to the Order of Reference, the Special Master conducted hearings, reviewed submissions from the parties, and issued a "Report of Special Master on Validity of U.S.

Patent No. 3,950,635 and a Report of Special Master on Validity of U.S. Patent No. 4,438,491" (the "Master's Report"). (Transcript of Hearing before Special Master Hillman on September 4, 1986; Transcript of Hearing before Special Master Hillman on October 29, 1986; Order of Reference; Master's Report).

8. Following submission of the Master's Reports, Plaintiff filed a Motion to Disqualify the Special Master on various grounds. This Court held a hearing on March 16, 1987 on Plaintiff's Disqualification Motion. Having considered Plaintiff's arguments and evidence, the court denied Plaintiff's Disqualification Motion as being without factual basis.

9. This Court received the

Master's Reports and thereafter held hearings on March 30, 1987 and May 4, 1987. At these hearings, Constant had an opportunity to extensively examine the Special Master concerning the bases for the Special Master's recommendation. The Master's Reports are attached hereto as Exhibits A and B. This Court adopts the Master's Reports and independently makes these findings of fact and conclusions of law.

B. The '635 Patent - Findings of Fact

10. The '635 patent, titled "Digital Matched Filter and Correlator Using Random Access Memory," issued to James N. Constant on April 13, 1976 from application Serial No. 479,872 ("the '872 application") filed June 17, 1974. The '872 application was itself

a continuation-in-part of a subsequently abandoned earlier application, Serial No. 435,681 filed on January 23, 1974. Mr. Constant is the owner of the '635 patent and is the plaintiff in this action.

11. The Constant '635 patent describes and claims an invention relating to the digital implementation of "matched filters" and "correlators." Matched filters and correlators are used in a wide variety of electronic devices and perform a comparison of one electrical signal with a second electrical signal. One or both of the signals may be stored. (Appendix A of the Motion; Master's Report at 1).

12. More specifically, a "correlator"is a type of device in which the two electrical signals are

changing constantly, whereas a "matched filter" is a type of device in which one of the electrical signals is a fixed signal that is stored in the device memory. (Appendix A of the Motion; Master's Report at 1-3, 13; '635 patent at col. 7, lines 33-65).

13. The comparison of signals is implemented in the '635 patent by first representing the electrical signals as two sequences of digital values, respectively. The digital values are supplied to an exclusive-or gate that provides one binary output if the two digital values are the same and produces the opposite binary output if the two digital values are not the same. A sequence of pairs of digital values can be compared and the binary output of the exclusive-or gate can be

added together to give a number that indicates the overall degree of similarity between the two electrical signals. (Appendix A of the Motion; Master's Report at 1-3).

14. The Constant '635 device operates under control of a clock, which supplies regularly timed pulses to the various elements so that the electrical signal values will move to the exclusive-or gate at the proper time. An address counter is used to ensure that the proper electrical signal values are supplied to the gate. (Appendix B of the Motion; Master's Report at 5-6).

15. An address counter is required with the Constant device because the memory used for the electrical signals is a type of memory

called "random access memory" or "RAM" for short. Access to RAM cells is random in the sense that any desired memory cell can be accessed by appropriate setting of the address counter value. The memory cell can be accessed on any particular clock pulse. (Appendix B of the Motion; Master's Report at 6).

16. A shift register is a type of memory in which memory cell locations are lined up in single file and can be accessed only through the ends. No address counter is needed to control access to this type of memory. (Master's Report at 6-7).

17. In many signal processing applications using correlators or matched filters, the signals are stored in a "delay line" and then retrieved at

a rate greater than the rate of storage. This is often called time compression. A delay line is a data signal loop having a memory such that data is stored in the memory and released some time thereafter. One implementation of a delay line is the delay line time compressor (DELTIC), which recirculates signals in successive sampling intervals. ('635 patent at column 2, lines 21-29 and column 3, lines 48-57; Master's Report at 7-8 and 12-13).

18. The '635 patent contains fourteen claims. Claims 1 and 10 are independent claims directed to the digital implementation of matched filters and correlators. Claim 11 is an independent claim directed to a method for the digital implementation

of matched filters and correlators. The remaining claims are dependent claims.

19. Constant concedes that the only difference between the '635 patent and the prior art is the use of RAM, along with the required addressing circuitry, in place of shift register memory, in a correlator or matched filter. ('635 patent at column 2, lines 40-63; Master's Report at 7-8).

20. "Digital Compressed-Time Correlators and Matched Filters for Active Sonar" by W.B. Allen and E.C. Westerfield (the "Allen and Westerfield publication") was published in January of 1964 in the Journal of the Acoustical Society of America. (Exhibit L of Motion for Summary Judgment and Master's Report at 14).

21. The Allen and Westerfield publication describes delay line time compressors or DELTICs having either an acoustic or a shift register delay line and, as an alternative to either the acoustic or shift register delay line, the use of magnetic core memory in the delay line. The magnetic core memory delay line is illustrated in Figure 13 of the Allen and Westerfield publication and is referred to as a "MACOMATIC" or magnetic core matrix time compressor. (Exhibit L of Motion for Summary Judgment; Declaration of Professor Lawrence P. McNamee in Support of Motion (the "McNamee Declaration") at ¶¶9-11; Master's Report at 14-16).

22. Magnetic core memory is an early form of RAM that used magnetic

elements to store digital bits of data, rather than the semiconductor storage elements used in modern technology. Nevertheless, magnetic core memory is RAM; namely, it has the ability to access any memory cell location at random by simply addressing that cell directly. (McNamee Declaration at ¶8; Master's Report at 15).

23. The Allen and Westerfield publication fully discloses a matched filter or correlator using a random access memory. (McNamee Declaration at ¶¶9-11; Master's Report at 14-18, 24-29, 31-34).

24. U.S. Patent No. 3,295,107 for "Electronic Time Compression Device" issued on December 27, 1966 to Robert E. Stalcup (the "Stalcup patent"). (Exhibit K of the Motion for Summary

Judgment, Master's Report at 18).

25. The Stalcup patent fully discloses a matched filter or correlator using a random access memory for the delay line memory. (Stalcup patent at col. 1, line 70-col. 2, line 3; McNamee Declaration at ¶¶3-7; Master's Report at 18-24, , 29-34).

26. "High Speed Shift Registers Use TTL RAMs and Counters To Do All The Shifting by John Springer was published in Electronics Design on September 1, 1973 (the "Springer publication"). (Exhibit N of Motion for Summary Judgment; Master's Report at 13-14).

27. The Springer publication fully discloses in general the idea of using RAM in place of shift register memory. Springer does not explicitly apply that idea to matched filter or

correlators. (Exhibit N of Motion for Summary Judgment; McNamee Declaration at ¶14; Master's Report at 13-14).

28. The Springer publication was published prior to the date of conception of the device embodied in the '635 patent. Constant has admitted that the Springer publication taught him the use of RAM as a shift register and that Constant thereafter conceived of the device embodied in the '635 patent. (Deposition of James Constant conducted on March 20, 1986 at 79, line 23 to 80, line 2; Plaintiff's Objections to Master's Report-Part 2B, Exhibit 2; '635 Patent at column 4, lines 21-24; Master's Report at 13-14).

29. The Stalcup patent and the Allen and Westerfield publication disclose each and every element of

claims 1, 2, 6, 8, 9, and 11-14 of the '635 patent. The Allen and Westerfield publication in addition discloses each and every element of claim 7. (Master's Report at 24-30, 34-38). Constant's arguments with respect to the definition of RAM, the address "decoder," sequential addressing, clocking, shifting, and multiplying, are wholly lacking in any substance or support for the reasons set forth by the Master (id). These arguments do not raise any genuine issue of fact. (Master's Report at 24-30, 34-38).

30. Claim 1 of the '635 patent requires a first memory 1 and a second memory 11. Claim 1 requires the first memory to be RAM and allows the second memory to be any type of memory. Claim 2 requires that the second memory also

be RAM. The teachings of the Allen and Westerfield and Stalcup references are as exactly applicable to claim 2 as they are to claim 1, and therefore each of these references discloses each and every element of claim 2. (Motion at 16-18 and 47; Master's Report at 34).

31. The Allen and Westerfield publication and Stalcup patent both teach replacing shift registers with RAM in correlators and matched filters and the Springer publication teaches such a replacement generally. For the reasons set forth below, any one of these prior art references overwhelmingly, clearly and convincingly renders all claims of the '635 patent obvious. (Master's Report at 13-14, 31-38).

32. Constant has asserted that

the level of ordinary skill in the art would be an individual having a Ph.D. in electrical engineering or physics; this is undisputed. (Texas Instruments Memorandum of Points and Authorities in Support of Motion for Summary Judgment at 29; Deposition of James Constant conducted on March 20, 1986 at 118-19).

33. Claim 3 requires the second memory to be a read only memory and claim 4 requires the second memory to be a programmable read only memory, and claim 5 requires the second memory to be a bipolar signal generator. These are the only differences between those respective claims and the Stalcup and Allen and Westerfield references. ('635 patent).

34. It is uncontested that read only memory, programmable read only

memory and bipolar signal generators are alternative forms of random access memory and were so understood prior to Constant's claimed invention; Constant himself in the '635 patent acknowledges the equivalence between "a number of forms " of random access memory, including specifically DELTIC loop circuits, read only memory, programmable read only memory, and bipolar signals applied to a multiplier. ('635 patent, col. 4, lines 3-17; McNamee Declaration at ¶8; Master's Report at 35-36).

35. It would have been obvious for a person of ordinary skill in the art to substitute for the second memory a read only memory (claim 3), programmable read only memory (claim 4), or means for generating bipolar

signals (claim 5), as specified in the '635 patent, for the same reasons as claims 1 and 2, the additional elements of claims 3, 4, and 5 being equivalent to the elements of claims 1 and 2. (Motion at 16-18, 19-22, 47, 50-55; Master's Report at 35-36).

36. Claim 6 requires that the second memory be a DELTIC circuit; claim 8 requires that the first memory be a DELTIC circuit. These features are present in the Allen and Westerfield publication and also in the Stalcup patent, and therefore each of these references discloses each and every element of claims 6 and 8. ('635 patent; Master's Report at 36).

37. Claim 7 requires that the multiplier means of claim 1 be a set of multipliers, a feature present in

Figure 24 of the Allen and Westerfield publication. Thus, the Allen and Westerfield publication discloses each and every one of the elements of claim 7. ('635 patent; Master's Report at 37).

38. Claim 9 requires that the clock means of claim 1 includes a means for shifting the second signals in the second memory. This feature is disclosed by the Allen and Westerfield publication and by the Stalcup patent, so the each one of these references discloses each and every one of the elements of claim 9. ('635 patent; Master's Report at 37).

39. Claim 10 of the '635 patent discloses an admittedly prior art system using shift register memory, except that the first memory is

implemented as RAM rather than as a shift register. ('635 patent; Master's Report at 37).

40. It would have been obvious to one of ordinary skill in the art to substitute RAM for only one of the memories, just as well as substituting RAM for both of the memories, in view of the prior art references by either ALlen and Westerfield or by Stalcup. (Master's Report at 37).

41. Claim 11 of the '635 patent is a method claim which is the counterpart of the apparatus claim 1 and therefore each and every step of claim 11 is disclosed by each of the Allen and Westerfield or Stalcup references, which therefore anticipate claim 11. It also would have been obvious to one of ordinary skill in the

art to perform each and every one of the steps of claim 11 in view of either of those same references combined with the Springer publication. Such a combination is invited by Springer. (Master's Report at 38).

42. Claim 12 is a method claim which is the counterpart of claim 6, requiring the second memory to be a DELTIC circuit. Both the Allen and Westerfield and Stalcup prior art references disclose each and every one of the steps of claim 12. It also would have been obvious for one of ordinary skill in the art to perform each and every one of the steps of claim 12, in view of the same references combined with the Springer publication. (Master's Report at 38).

43. Claim 13 is a method claim

which is the counterpart of claim 8, requiring the first memory to be a DELTIC circuit. Both the Allen and Westerfield and Stalcup prior art references disclose each and every one of the steps of claim 13. It also would have been obvious to one of ordinary skill in the art to perform each and every one of the steps of claim 13, in view of the same references combined with the Springer publication. (Master's Report at 38).

44. Claim 14 is a method claim which is the counterpart of claim 9, requiring that the samples in the second memory be shifted as well as the samples in the first memory. Both the Allen and Westerfield and Stalcup prior art references disclose each and every one of the steps of claim 14. It also

would have been obvious to one of ordinary skill in the art to perform each and every one of the steps in claim 14, in view of the same references combined with the Springer publication. (Master's Report at 38).

C. The '635 Patent: CONCLUSIONS OF LAW

1. Jurisdiction is proper in this Court under 28 U.S.C. § 1338 (a) and (b).

2. Summary judgment is as appropriate in a patent case as in any other. Where no genuine issue of material fact remains and the moving party is entitled to judgment as a matter of law, courts should utilize Rule 56 of the Federal Rules of Civil procedure to avoid unnecessary expense to the parties and wasteful utilization

of the jury process and judicial resources. Barmag Barmer Maschinenfabrik AG v. Murata Machiner, Ltd., 731 F.2d 831, 835 (Fed. Cir. 1984).

3. With respect to whether there is a genuine issue of material fact, a court may not simply accept a party's statement that a fact is challenged. The party opposing a motion for summary judgment must point to an evidentiary conflict created on the record by at least a counter statement of facts set forth in detail by a knowledgeable affiant. Mere denials or conclusory statements are insufficient to create a genuine issue of material fact. Barmag, 731 F.2d at 836. Constant has presented no evidence at all of a genuine issue of material fact.

4. A statement by an applicant, whether in the application or in other papers submitted during prosecution of the application, that certain matter is "prior art" to the applicant is an admission that the matter is prior art for all purposes. In re Nomiya, 509 F.2d 566, 571 at n. 4 (C.C.P.A. 1975).

5. A patent is presumed valid under 35 U.S.C. § 282, and one attacking validity has the burden of proving invalidity by clear and convincing evidence. Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1375 (Fed. Cir. 1986).

6. A patent claim is anticipated under 35 U.S.C. § 102 is each element of the claim is found, either expressly described or under principles of inherency, in a single prior art

reference or if the claimed invention was previously known or embodied in a single prior art device or practice. That is, all the limitations of a claim must be found in a single reference. Kalman v. Kimberly Clark Corporation, 713 F.2d 760, 771 (Fed. Cir. 1983).

7. In determining obviousness under 35 U.S.C. § 103, the scope and content of the prior art are determined; differences between the prior art and the claims at issue are ascertained; and the level of ordinary skill in the pertinent art are resolved. Secondary considerations having a nexus to the claimed invention, such as commercial success, long felt but unsolved needs, and failure of others are to be utilized to give light to the circumstances

surrounding the origin of the subject matter sought to be patented and may have relevancy. Graham v. John Deere Company, 383 U.S. 1, 17-18 (1966); Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 1538-39 (Fed. Cir. 1983).

8. There is no evidence that any of the secondary factors are relevant in the present case. There is no evidence of a long felt need and no evidence of commercial success to the claimed invention. (Master's Report at 31-32).

9. Obviousness under 35 U.S.C. § 103 is a question of law based on underlying fact issues. Union Carbide Corporation v. American Can Company, 724 F.2d 1567, 1573 (Fed. Cir. 1984).

10. The Allen and Westerfield and Stalcup references anticipate claims 1,

2, 6, 8, 9 and 11-14 under 35 U.S.C. § 102(b) by clear and convincing evidence and rebut the presumption of validity that attaches to a patent under 35 U.S.C. § 282. The Allen and Westerfield reference similarly anticipate claim 7. (Findings of Fact 19-45).

11. Each of claims 1 through 14 of the '635 patent are rendered obvious under 35 U.S.C. § 103 by the Allen and Westerfield and Springer references and by the Stalcup and Springer references by clear and convincing evidence, and these references rebut the presumption of validity that attaches to a patent under 35 U.S.C. § 282. (Findings of Fact 19-45).

12. The '635 patent is thus invalid in its entirety.

13. Any finding of fact determined to be a conclusion of law is so deemed, and any conclusion of law determined to be a finding of fact is so deemed.

Respectfully submitted,
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UNITED STATES DISTRICT COURT
FOR THE CENTRAL DISTRICT OF CALIFORNIA

Civil No. 85 0262 SVW (Bx)

FINDINGS OF FACTS AND CONCLUSIONS OF LAW RE: SUMMARY JUDGMENT OF INVALIDITY OF U.S. PATENT No. 4,438,491.

Judge Stephen V. Wilson

JAMES CONSTANT,

Plaintiff,

v.

ADVANCED MICRO-DEVICES, INC., ET AL.,

Defendants.

INTRODUCTION

The Court, having considered the Motion by Intel Corporation ("Intel"), joined by Texas Instruments, Inc. for summary judgment of invalidity of U.S.

Patent No. 4,438,491 and having considered the submissions and evidence of the parties makes the following Findings of Fact and Conclusions of Law:

1. This is patent infringement suit involving inter alia, U.S. Patent No. 4,438,491 ('491) issued by the U.S. Patent and Trademark Office ("PTO") on March 20, 1984. Plaintiff James Constant, the owner and named inventor of the '491 patent has sued Intel Corporation ("Intel") and the other Defendants in this action for infringement of the '491 patent. Plaintiff originally alleged that a semiconductor "chip" manufactured by Intel, Part No. 2920, infringes the '491 patent. Plaintiff has also alleged infringement of that patent by

other chip products made by the other Defendants to this action. Defendant Intel, a California corporation, filed a motion for summary judgment under F.R.Civ.P. 56 (Intel's Motion) claiming the '491 patent is invalid since among other reasons the 2920 was on sale more than one year before the filing of the application which resulted in the '491 patent.

THE '491 PATENT

2. The application for the '491 patent was filed with the PTO on October 14, 1980; consequently, any activity prior to October 14, 1979 is more than one year prior to the date of the application for the '491 patent.

3. The '491 patent describes the interconnection of semiconductor chips which are used in computers.

4. Digital signals used in computers are binary values having two possible values, 0 and 1, which are generally represented by two different voltage levels (e.g., 0 volts and 5 volts). Several of these binary "bits" are typically used to represent a numerical value. In contrast, analog signals are represented by a continuum of voltage levels rather than discrete voltage levels associated with the 0's and 1's in a digital system. See paragraph 7 of the Declaration of Marcian E. Hoff, Jr., executed on December 12, 1985 (hereinafter referred to as "Hoff I Decl."). Thus a single analog voltage level on a single wire can represent the same number that would require several wires to represent instantaneously in digital

form.

5. Figure 1 of the '491 patent shows that in what the patent characterizes as prior art, several wires are used to connect signals between chips; for example, one wire for each bit of a digital signal. Each wire connected to a chip requires a bonding pad to which the wire is attached. These pads occupy a portion of the semiconductor chip. Therefore, several pads are needed on each of the chips to interconnect a digital signal between the chips.

6. Also, included on these chips, such as those shown in Figure 1 of the '491 patent, are logic circuits. The logic circuits, in the prior art (and in the invention), perform the manipulation of data and signals to

achieve the results desired by the designer. The logic circuits on the computer chips used in the prior art and in the claimed invention generally operate directly on digital signals. Figure I prior art, a logic circuit on one chip communicates with a logic circuit on another chip through the several wires connected between the chips; for example, a four bit digital word would be transmitted over the four wires shown in Figure I. Each wire requires a pad on each chip; therefore each chip must devote valuable area for these pads.

7. Figure 2 of the '491 patent shows an embodiment of the claimed invention where, as it can be seen, the number of wires between the chips has been reduced to a single wire. Some of

the pads on each chip have been eliminated and replaced with a transmitter - receiver ("transceiver") which is connected between a pad and the logic circuits. A single wire links the pads between two chips to permit the logic circuits on each of the chips to communicate.

8. The '491 patent gives a number of examples for transceivers. For example, the '491 patent notes that a transmitter may be a digital-to-analog (D/A) converter and the receiver may be an analog-to-digital (A/D) converter.

9. An analog-to-digital ("A/D") converter is an electrical circuit that converts an analog signal to a digital signal. Hoff I Decl. para. 7.

10. A digital-to-analog ("D/A") converter is also an electrical

circuit, but it performs the opposite function. It converts a multi-line digital signal to a single-line analog signal. For example, 8 bits (on eight wires or lines) each representing a "1" or a "0" are converted to an analog signal on a single wire or line. Declaration of Marcian E. Hoff, Jr. (HOFF III DECL.) filed November 15, 1986, para. 5.

11. In Figure 2 of the '491 patent, the output from the logic circuit on chip 1 is connected to the transceiver 15 which, in one embodiment, includes a D/A converter which acts as a transmitter by converting the digital signals to an analog signal. The analog signal is carried to the pad 11 and then over the single line 31 to pad 21 on chip 2.

Pad 21 is connected to a receiver, specifically an A/D converter 25 which reconverts the analog signal to digital signals for use by the logic circuit on chip 2.

12. The goal of the '491 patent is "to reduce the on-chip area devoted to interface and to reduce the number of wires needed for interconnecting chips of a computer. The method of the invention is equally simple, namely, the steps of including at least one of a transmitter and receiver means in a monolithic IC chip and interconnecting chips to form a computer." (col. 6, line 50 to col. 7, line 3, '491 patent). The foregoing concept is claimed in varying embodiments in the 30 claims of the '491 patent; these embodiments vary in terms of the

particular transceiver used.

13. It is undisputed that the numerous transceiver examples described in and appearing in the claims of the '491 patent, such as modems, shift registers, A/D converters, codecs, etc. were well-known elements when the application for the '491 patent was filed. The '491 patent states that the choice of the transceivers is "a standard communication task." Col. 4, 1-11, '491 patent.

14. The 2920 is a digital microcomputer chip developed and manufactured by Intel. The development of the 2920 began in late 1975 and culminated in 1979 with the introduction of this part, after testing of the part during March 1979. (Hoff I, Decl., para. 6). Photographs

of the 2920 chip were published during March 1979. See Hoff I Decl. Exhibit 3.

15. There are several articles describing the 2920 which were published more than one year before the filing date of the '491 patent (Hoff I Decl. Exhibits 2-9).

16. Intel offered the 2920 for sale no later than September 1979 and fulfilled an order from General Electric for a 2920 in September of 1979. (Decls. of Elmer Cougle, Dennis Lundien, and Donald Ellers, all filed December 18, 1985.)

17. Plaintiff admitted that the Intel 2920 was sold as early as September 1979 and that "Intel first started advertising the 2920 for sale in September, 1979." (Paragraph 11 of

Decl. of Plaintiff James Constant executed 13 April, 1987.)

18. Initially, Intel's Motion relied substantially on its September 1979 sale as the basis for invalidity under 35 USC 102(b). Texas Instruments, another defendant, joined on the motion. Plaintiff opposed Intel's motion by asserting that the 2920 chip itself did not come within the claims, but only because the single chip which was placed on sale lacked the preamble of the claims of the '491 patent, that is, it was not in a computer, etc. Intel than filed additional motion papers relying on the 2920-related publication and the Field patent.

19. Plaintiff's first letter to Defendant Intel charging infringement

advised Intel that the 2920 chip infringed the '491 patent: "Your 2920 Signal Processor infringes Claims 1, 7, 8, 9, 16, 18 and 23, as minimum, of my enclosed patent... In these circumstances, you will have to stop making, using and selling A/D and D/A units in 2920 or take a licence under my patent." Also, in the original complaint and first amended and second amended complaints, Plaintiff alleged that the 2920 chip infringed the '491 patent.

THE UNCONTROVERTED EVIDENCE ESTABLISHES THE INVALIDITY OF THE 491 PATENT

20. Intel has shown that the 2920 has all the elements of Claims 1, 7, 8, 9, 16, 18, 21, 22 and 23 (except the preamble). Plaintiff agrees with this in general although without setting

forth the specific claims. Plaintiff states that this is not sufficient for anticipation since the sale of the 2920 did not fulfill the preamble of the claims (e.g., the chip was not sold interconnected to other chips in a computer). Intel has argued that this preamble need not be shown and that therefore the sale of the 2920 alone invalidates the '491 patent. This Court, for purposes of this motion, assumes that Plaintiff is correct in requiring a showing that the conditions of the preamble have been met. Therefore, the Court has examined the publications for the preamble of the claims as well as all other elements of the claims.

21. Hoff I Decl. Exhibit 5 is a printed publication which was made

publicly available by Intel beginning in September 1979. (Decl. of Sherrie Zirkle filed April 9, 1987.) Plaintiff has stated that this publication should not be considered because it was stamped "Advanced Information." The Court disagrees with Plaintiff. The document was publicly available, without restriction.

22. Hoff I. Decl. Exhibit 5 discloses the subject matter claimed in Claims 1, 7, 8, 9, 16, 18, 21, 22, and 23 including the preamble. For example, Hoff I Decl. Exhibit 5 describes the cascading of multiple 2920s where the output of one 2920 chip is connected to the input of a second 2920 chip and so on with further 2920s if desired. A normal and intended use of 2920s in such a cascade would be to

communicate between the chips with analog signals which are converted into digital signals for internal processing in the micro computers within the 2920 chips. A reduction of interconnections inherently occurs in such an arrangement. Moreover, Plaintiff admits Exhibit 5 of Hoff I Decl. teaches computer applications of the 2920. See Plaintiff's Presentation '491 Patent (dated October 29, 1986), pages 3 and 4.

23. The 2920 is a more complex chip than that shown in Figure 2 of the '491 patent. It can, for example, receive up to four analog signals and change one or more of them to digital signals, Likewise, it can output more than one analog signal. The use of a single analog signal into and from the

2920 is a subset of the 2920's total capability; this single input and output use is clearly shown in Figure 1 of Exhibit 9. Therefore, the cascading of the chips in its simplest form provides what is shown in Figure 3 of the '491 patent (compare Figures 2 and 3 of '491 patent with Exhibits 5 and 9).

24. It is possible to program the 2920 for applications where there is no reduction of interconnections. This does not change the fact that the uses described above automatically reduces interconnections, and such reductions are inherent in the descriptions of applications for the 2920 in Hoff I Decl. Exhibit 5.

25. Hoff I Decl. Exhibit 9 is a printed publication which was

distributed publicly as part of a magazine in September 1979. (Decls. of Kimberly Douglas and Lori Shulman, filed April 9, 1987.)

26. Hoff I Decl. Exhibit 9 describes the 2920 chip and several applications for this chip, including a signal processing application.

30. The record shows by clear and convincing evidence that the 2920 chip, and uses for that chip, were widely publicized by Intel more than one year before the filing of the '491 patent application in various printed publications including Hoff I Decl. Exhibit 9.

31. Applications intended and described for the 2920 in these printed publications prior to October 1979 include multi-chip applications

involving computers in which the interconnections between chips is reduced because of the use of the A/D and D/A converters on the 2920. The various block diagram illustrations of the 2920 shown in Hoff I Decl. Exhibits 3, 5 and 9 indicate that a reduction of interconnections will take place when an analog signal is converted to a digital signal and than processed by the 2920.

32. Mr. Constant has, after Mr. Hillman's Report on the '491 patent, asserted that the publications do not anticipate because they do not show a specific computer program. The claims of the '491 patent relate to a set of physical ("hardware") components. The claims do not require a computer program. The specification of the '491

patent, in accordance with the claims of the patent, does not disclose any specific computer program nor does it suggest that a computer program is a part of the invention.

33. The persons working in the field to which the '491 patent belongs during the period 1977-1979 were highly skilled. Dr. Hoff of Intel had a PhD in engineering and many years of experience in electrical engineering. He headed up Intel's development of the 2910 and 2920. Plaintiff contends that a person of ordinary skill in the art is a "DSP (digital signal processing) designer, user, teacher or author who has considerable experience ... in dealing with interconnecting DSP chips." (Plaintiff's Objections to Master's Report, Part 1, dated February

17, 1987, page 7.) Also Plaintiff states persons working in the field of the related patent in suit (3,950,635) have at least one college degree in engineering or physics (Deposition of Constant, Pages 115-119, Vol. 1, March 20, 1986). Therefore, one of ordinary skill in the art during the pertinent period had a degree in science, experience in electrical engineering and some experience in digital signal processing chips.

34. Certain claims of the '491 patent (i.e., Claims 2-6, 10-15, 17, 19-20 and 24-30) are not completely described in Intel's Exhibits 5 or 9 of Hoff I Decl. These claims ("Remaining Claims") relate to the use of certain equivalent structures which are substituted in place of the transmitter

or receiver, such as the A/D or D/A converter. Plaintiff James Constant concedes in the '491 patent that these equivalent transmitter and receivers are conventional communication system elements which may be implemented by one with ordinary skill in the art. See, e.g., Column 3, lines 60-66 of the '491 patent; column 4, lines 11-13 of the '491 patent; and Plaintiff's Amendment submitted to the U.S. Patent Office which Amendment is dated August 26, 1983. (See, e.g., pages 12-13 of that Amendment: "In view of the foregoing references for placing LEDs and photodetectors on chips (Moulton, Fang), for use of acoustic wave connections (U.S. Patent 4,035,775), for placing optical means on a chip and using fiber interconnections (Math,

Moulton, Gadzinsky, Fang), for placing microwave means on chips and using microwave cable interconnections (Sobol), for placing A/D and D/A converters on a chip (Runyon), for placing logic circuits and interfacing means on a chip (Scientific American), for placing modems and codecs on a chip (Young, Pastorino, Mayo in Scientific American, Miller, Hoff), the placing of samplers and multiplexers on chips (Mayo in Scientific American, Hoff, Faggian), and the connection of logic circuits to communications interfaces on a chip (Sutherland and Mead in Scientific American, page 211), the placing and connection of applicant's logic circuits and transceivers on the same chip can be made without undue experimentation by the routineer.")

These statements in the file wrapper of the '491 patent reflect upon the ordinary skill in the art and define generally the art and the skill of the art.

35. The differences between the subject matter of the "Remaining Claims" are simply the substitution of Hoff I. Decl. Exhibit 5 with various types of well-known transmitters and receivers.

36. Exhibits 3, 5, and 9 of Hoff I Decl. taken together render the subject matter of the Remaining claims obvious to one with ordinary skill in the art. There is no evidence of any secondary factors that weigh against obviousness.

CONCLUSIONS OF LAW

1. Conclusions 1-9 set forth

above in connection with the '635 patent are incorporated herein by reference.

2. Summary judgment is appropriate when there is no genuine issue of material fact and the movant is entitled to judgment as a matter of law. See, e.g., SRI International v. Matsushita Electric Corp. of America, 775 F.2d 1107, 1116 (Fed. Cir. 1985); Chore-Time Equipment, Inc. v. Cumberland Corp., 713 F.2d 774, 778 (Fed. Cir. 1983). The moving party bears the burden of demonstrating an absence of all genuine issues of material fact. Cooper v. Ford Motor Co., 748 F.2d 677, 679 (Fed. Cir. 1984). However, where the evidence on an issue leaves no room for any reasonable difference of opinion as to

its resolution, the District Court should resolve such issue as a matter of law. Jamesbury Corp. v. Litton Industrial Products, Inc., 756 F.2d 1556, 1560 (Fed. Cir. 1985). Indeed, once a prima facie case for summary judgment exists, the party opposing the motion must point to a material evidentiary conflict created on the record. And mere denials or conclusory statements are insufficient. Barmag Barmer Maschinenefabrik AG v. Murata Machinery Co., Ltd., 731 F.2d 831 (Fed. Cir. 1984).

3. A printed publication which describes a patented invention anticipates that patented invention if the printed publication was published more than one year before the filing of the application resulting in the

patent. 35 USC 102(b).

4. A printed publication exists for purposes of Section 102(b) if even a limited number of copies of the publication were publicly available to those in the art seeking to obtain the publication. Hamilton Laboratories v,. Massengill, 111 F.2d 584 (6th Cir. 1940), cert. den. 311 U.S. 688.

5. Hoff I Decl. Exhibits 3, 5 and 9 are printed publications under 35 USC 102(b) which anticipate Claims 1, 7, 8, 9, 16, 18, 21, 22, and 23 of the '491 patent, rendering those claims invalid.

7. The 2920 chip, for purposes for USC 102(b), was placed on sale by Defendant Intel more than one year before the filing date of the '491 patent. Thus, tne 2920 chip is in the prior art with respect to the '491

patent.

8. Hoff I Decl. Exhibit 5 inherently discloses the inventions in Claims 1, 7, 8, 9, 16, 18, 21, 22, and 23 of the '491 patent. Printed publications which inherently disclose an invention anticipate the invention. Tyler Refrigeration v. Kysor Industrial Corp., 777 F.2d 687 (Fed. Cir. 1985).

9. A reference does not anticipate an invention if the reference achieves an anticipation that was unintended and unappreciated and was not a necessary consequence of the use of the object in the prior art. Tilghman v. Proctor, 102 U.S. 707, 26L. Ed. 279 (1881). Intel's references anticipate because the reduction of interconnections using the 2920 are intended consequences of the placement

of the transmitter and receiver on the chip and the reduction of interconnections occurs as a necessary consequence of intended and described uses.

9. Claims 11, 7, 8, 9, 16, 18, 21, 22 and 23 of the '491 patent are thus invalid for anticipation by Hoff I Decl. Exhibit 5, under 35 USC 102(b).

10. The Remaining Claims of the '491 patent are invalid for obviousness under 35 USC 103. Application of Borcherdt, 197 F.2d 550 (CCPA 1952); Application of Stewart, 222 F.2d 747 (CCPA 1955).

11. All of the claims of the '491 patent are invalid as to all Defendants in this action and therefore, all allegations of infringement of the '491 patent against all Defendants are

dismissed with prejudice.

Dated:October 28, 1987

Judge Stephen V. Wilson

Presented by:

BROWN & BAIN
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN

Edwin H. Taylor
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SUBMITTED ON BEHALF OF ALL DEFENDANTS

UNITED STATES DISTRICT COURT
FOR THE CENTRAL DISTRICT OF CALIFORNIA
No. 85 0262 SVW (Bx)
ORDER GRANTING DEFENDANTS' MOTION TO RETAX COSTS AND DENYING PLAINTIFF'S MOTION TO DISMISS AND DISALLOW COSTS AND FOR SANCTIONS

DATE: May 2, 1988
TIME: 1:30 p.m.
PLACE: Courtroom F

JAMES CONSTANT
Plaintiff,

v.

ADVANCED MICRO-DEVICES, INC., at al.,
Defendants.

Defendants' motion to retax certain costs and plaintiff's motion to dismiss determination of costs, disallow costs and for sanctions against defendants came on for hearing before the United States District Court, Honorable Stephen V. Wilson presiding, on May 2, 1988 at 1:30 p.m., upon due notice. Defendant Fujitsu Microelectronics, Inc. ("FMI") appeared through its counsel, Adrian M. Pruetz of Morrison & Foerster, and FMI represented the position of all defendants in the matter. Plaintiff James Constant appeared in his own behalf. The Court, having reviewed the memoranda, evidence and legal authorities filed in support of and in opposition to defendants' motion to retax certain costs and plaintiff's

motion to dismiss and disallow costs and for sanctions, and having heard the arguments presented at the hearing;

IT IS HEREBY ORDERED:

1. Plaintiff's request that this Court recuse itself is DENIED.

2. Defendants' motion to retax the costs of the Special Master Robert Hillman and the costs of reproduction of specified documents against plaintiff is GRANTED, and plaintiff is ordered to pay defendants' costs for those items in the amount of $95,289.71.

3. Plaintiff's motion to dismiss determination of costs, to disallow costs and for sanctions is DENIED, the costs taxed by the Clerk of Court in the Bill of Costs are affirmed, and plaintiff is ordered to pay defendants

costs for those specified items in the amount of $28,542.29.

4. In accordance with the foregoing orders, costs in the total amount of $123,832.00 shall be entered into and made part of the Judgment entered in favor of defendants and against plaintiff on November 9, 1987, such costs to bear interest at the legal rate from date of entry, and such costs when recovered shall be payable to each defendant in the amount allowed.

DATED: May 10, 1988

Honorable Stephen V. Wilson
United States District Judge

CERTIFICATE OF SERVICE

I certify that the foregoing

APPENDIX B

was served on all parties on

17 August, 1988

by mailing first class a true and correct copy thereof to them addressed as follows:

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(4)

No. 88-308

Supreme Court, U.S.
FILED
SEP 17 1988
JOSEPH F. SPANIOL, JR.
CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM 1988

JAMES CONSTANT,

Petitioner,

v.

ADVANCED MICRO-DEVICES, INC., GOULD, INC., AMERICAN MICROSYSTEMS, INC., ANALOG DEVICES, INC., FUJITSU, LTD., FUJITSU MICROELECTRONICS, INC., DIGITAL SWITCH, INC., GRANGER ASSOCIATES, INC., HITACHI CORPORATION, INTEL, INC., INTERACTIVE CIRCUITS & SYS. LTD., MATSHUSHITA ELECTRONICS CORP., COMPUTER MODULES, INC., NIPPON ELECTRIC CO., LTD., NEC ELECTRONICS USA, PARADYNE CORPORATION, SEMICONDUCTOR PRODUCTS, TEXAS INSTRUMENTS, INC., and TRW, INC.

Respondents.

ON PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF FOR RESPONDENTS IN OPPOSITION

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Attorneys for Respondent Paradyne Corporation Submitted on Behalf of All Respondents.

QUESTIONS PRESENTED FOR REVIEW

Paradyne Corporation, speaking on behalf of all respondents (hereinafter, collectively referred to as "Paradyne"), presents this statement of the Questions Presented for Review because Paradyne disagrees that Petitioner, James Constant, ("Petitioner" or "Constant") has accurately framed the questions presented in the Petition for Certiorari ("Petition"). Accordingly, Paradyne provides the following statement of Questions Presented for Review:

1. Whether the United States Court of Appeals for the Federal Circuit ("the Federal Circuit") improperly decided that 35 U.S.C. Section 282, which permits the federal courts to adjudicate the validity of patents when invalidity is raised as an affirmative defense in an infringement action was constitutional and, that the congressional creation of the Patent and Trademark Office reexamination procedure did not divest the courts of the power to review patent validity.

2. Whether the United States District Court for the Central District of California abused its Discretion in its taxation of costs against Constant and whether such taxation of costs by the district court in a civil action comes within the excessive fines clause and constitutes cruel and unusual punishment pursuant to the Eighth Amendment and a denial of due process pursuant to the Fifth Amendment to the Constitution.

3. Whether the Judgement of the Federal Circuit holding the two patents in suit invalid was proper.

TABLE OF CONTENTS

	PAGE
QUESTIONS PRESENTED FOR REVIEW	i
TABLE OF CONTENTS	ii
TABLE OF CASES, STATUTES AND OTHER AUTHORITIES	iv
STATEMENT OF RELATED CASES	vi
OPINION BELOW	1
JURISDICTION	1
STATEMENT OF THE CASE	2
SUMMARY OF ARGUMENT	4
ARGUMENT	5
I. THE FEDERAL CIRCUIT PROPERLY DECIDED THAT 35 U.S.C. SECTION 282, PERMITS THE FEDERAL COURTS TO ADJUDICATE THE VALIDITY OF PATENTS WHEN INVALIDITY IS RAISED AS AN AFFIRMATIVE DEFENSE IN AN INFRINGEMENT ACTION AND THAT THE CONGRESSIONAL CREATION OF THE PATENT AND TRADEMARK OFFICE REEXAMINATION PROCEDURE DID NOT DIVEST THE COURTS OF THE POWER TO REVIEW PATENT VALIDITY	5
A. The District Court had Jurisdiction to Determine Validity	5
B. Patent Office Reexamination Proceedings are Limited in Scope and Could not have Considered the Evidence that Contributed to a Finding of Invalidity in the District Court	6

PAGE

II. THE DISTRICT COURT DID NOT ABUSE ITS DISCRETION IN ITS TAXATION OF COSTS AND SUCH TAXATION OF COSTS BY THE DISTRICT COURT IN A CIVIL ACTION DOES NOT CONSTITUTE AN EXCESSIVE FINE NOR CRUEL AND UNUSUAL PUNISHMENT PURSUANT TO THE EIGHTH AMENDMENT AND A DENIAL OF DUE PROCESS PURSUANT TO THE FIFTH AMENDMENT TO THE CONSTITUTON 9

A. The Taxation of Costs in the District Court is not Properly before this Court since it is still Pending before the Federal Circuit 9

B. The Taxation of Costs in a Civil Action does not come within the Purview of the Excessive Fines Clause of the Eighth Amendment nor does it Constitute Cruel and Unusual Punishment 10

C. There has been no Abuse of Discretion in the Appointment of the Special Master 10

III. NO REASONS ARE RAISED BY CONSTANT ABOUT WHY A WRIT OF CERTIORARI SHOULD BE GRANTED TO REVIEW THE FEDERAL CIRCUIT'S AFFIRMANCE OF THE DISTRICT COURT'S JUDGMENT OF PATENT INVALIDITY 11

IV. CONCLUSION 16

TABLE OF CASES, STATUTES AND OTHER AUTHORITIES

Cases	PAGE
Argus Chemical Corp. v. *Fibre Glass-Evercoat Co.*, 759 F.2d 10, 14 (Fed. Cir. 1985)	13
Bailey v. *Andrew*, 811 F.2d 366 (7th Cir. 1987)	10
Bankers Life & Casualty Co. v. *Crenshaw*, 486 U.S. , 108 S. Ct. 1645, 1651 (1988)	10
Christianson v. *Colt Industries Operating Corp.*, 486 U.S. , 108 S. Ct. 2166, 100 L.Ed. 2d 811, 828 (1988)	12
Constant v. *Advanced Micro Devices, Inc.*, 848 F.2d 1560 (Fed. Cir. 1988)	*passim*
Crateo, Inc. v. *Intermark, Inc.*, 535 F.2d 862, 868 (9th Cir. 1976)	10
Graham v. *John Deere & Co.*, 383 U.S.1 (1966)	*passim*
In re Lanham, 1 USPQ 2d 1877 (Com. Pat. 1986)	7
In re Vamco, 752 F.2d 1564, 1577 (Fed. Cir. 1985)	12
Ingraham v. *Wright*, 430 U.S. 651 (1977)	10
Jones v. *Hardy*, 727 F.2d 1524 (Fed. Cir. 1984)	15
Lewmar Marine, Inc. v. *Barient, Inc.*, 827 F.2d 744, 747-48 (Fed. Cir. 1987)	12
Macri v. *United States*, 353 F.2d 804, 809 (9th Cir. 1965)	10
Palermo v. *Rorex*, 806 F.2d 1266 (5th Cir. 1987)	10
Revere v. *Massachusetts General Hospital*, 463 U.S. 239 (1983)	10
Titanium Metals Corp. of America v. *Banner*, 778 F.2d 775, 781 (Fed. Cir. 1985)	12
Statutes	
28 U.S.C. Section 1254(1)	1
28 U.S.C. Section 1920	10
35 U.S.C. Section 102	12
35 U.S.C. Section 102(b)	12
35 U.S.C. Section 103	3,12
35 U.S.C. Section 282	*passim*
35 U.S.C. Section 301	7

	PAGE
35 U.S.C. Sections 302 et. seq.	8,9
Regulations	
37 Code of Federal Regulations 1.552	7
37 Code of Federal Regulations 1.555	7
Constitution	
Article I Section 8, cl. 8	5
Eighth Amendment	5,10
Other Authority	
Manual of Patent Examining Procedure, (5th ed. 1983, rev. 1987), Section 2209	8
Manual of Patent Examining Procedure, (5th ed. 1983, rev. 1987), Section 2254	8
Manual of Patent Examining Procedure, (5th ed. 1983, rev. 1987), Section 2258	7

STATEMENT OF RELATED CASES

United States Court of Appeals for the Federal Circuit:

No. 88-1414
James Constant v. *Advanced Micro-Devices, Inc., et al.*

No. 88-1196
James Constant v. *Robert Hillman*

No. 88-1198
James Constant v. *Marcian Hoff, et al.*

No. 88-1197
James Constant v. *Hitachi America, Ltd., et al.*

No. 88-1195
James Constant v. *Stephen Wilson; Robert Hillman*

No. 88-308

IN THE

Supreme Court of the United States

OCTOBER TERM, 1988

JAMES CONSTANT,

Petitioner,

v.

ADVANCED MICRO-DEVICES, INC., GOULD, INC., AMERICAN MICROSYSTEMS, INC., ANALOG DEVICES, INC., FUJITSU, LTD., FUJITSU MICROELECTRONICS, INC., DIGITAL SWITCH, INC., GRANGER ASSOCIATES, INC., HITACHI CORPORATION, INTEL, INC., INTERACTIVE CIRCUITS & SYS. LTD., MATSHUSHITA ELECTRONICS CORP., COMPUTER MODULES, INC., NIPPON ELECTRIC CO., LTD., NEC ELECTRONICS USA, PARADYNE CORPORATION, SEMICONDUCTOR PRODUCTS, TEXAS INSTRUMENTS, INC., and TRW, INC.

Respondents.

ON PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF FOR RESPONDENTS IN OPPOSITION

OPINION BELOW

The opinion of the United States Court of Appeals for the Federal Circuit is reported at *Constant* v. *Advanced Micro-Devices, Inc.*, 848 F.2d 1560 (1988).

JURISDICTION

The Judgment of the court of appeals was entered on June 9, 1988 (Pet. App. A2-A3). A petition for rehearing was denied on July 8, 1988 (Pet. App. A63-A64). The petition for a writ of certiorari was filed on August 18, 1988. The jurisdiction of this Court is invoked under 28 U.S.C. Section 1254(1).

STATEMENT OF THE CASE

Constant has used the "Statement of the Case" to set before the Court's consideration innaccurate, erroneous, unsupported and irrelevant matters. To obviate any confusion, Paradyne provides a more complete statement of the background of this case relevant to the Petition before the Court.

In January, 1985, Constant filed a ten-count Complaint against seventeen defendants[1] alleging infringement of his United States Patent Nos. 3,950,635 (the "'635 patent") and 4,438,491 (the "'491 patent"). The Complaint also contained nine non-patent counts including challenges to the constitutionality of 35 U.S.C. Section 282 and federal funding of research and development. Upon motion of the Respondents, the district court (Honorable Pamela A. Rymer) dismissed all counts with the exception of the Count V alleging infringement of the patents in suit. The District Court later entertained and denied several motions by Constant attempting to revive the dismissed counts.

Respondents then filed counterclaims for declaratory relief pursuant to 35 U.S.C. Section 282, seeking to have the patents declared invalid, unenforceable and non-infringed. Respondents then filed motions for summary judgment on their counterclaims and plaintiff, in turn, filed motions for summary judgment on the issue of infringement. Thereafter, the case was transferred to the Honorable Steven V. Wilson for further proceedings.

With the agreement of all parties, Judge Wilson, in August, 1986 appointed a Special Master, Robert E. Hillman, to make recommendations to the court on issues of patent validity and infringement or non-infringement. Pursuant to the Order of Reference, the Special Master thereafter submitted his recommendations to the District Court, concluding that the patents are invalid. Only after the recommendation of invalidity was made to the District Court did Constant move to disqualify the Special

---

1. All of the facts concerning the underlying action are set forth in detail in the Federal Circuit opinion in *Constant* v. *Advanced Micro-Devices, Inc. etc. et.al.*, 848 F.2d 862 (Fed.Cir. 1988).

Master and strike his reports. The court ruled against Petitioners Motions to Disqualify and Strike, after hearings in which Constant was given the opportunity to question and examine the Special Master. The District Court then independently determined that there were no material issues of contested facts and accordingly entered summary judgment declaring the claims of the '495 and '635 Patents to be invalid under 35 U.S.C. Section 102(b) and 35 U.S.C. Section 103.

Thereafter, on or about December 12, 1987, Constant filed his appeal in the United States Court of Appeals for the Federal Circuit, *Constant* v. *Advanced Micro Devices, Inc. etc. et. al.*, Case No. 88-1101. On June 9, 1988, the United States Court of Appeals for the Federal Circuit affirmed the rulings of the district court in all respects.

Following the entry in judgment by the District Court, on November 24, 1987, Respondents requested the Clerk of the Court to tax the costs set forth in the Bill of Cost that they filed jointly. On March 28, 1988, the Clerk of the Court taxed costs against Constant in the amount of $29,320 for deposition costs, reproduction of exhibits, court-ordered service of plaintiff's pleadings and patent file materials. The Clerk however disallowed costs for the fees defendants paid to Special Master Robert Hillman, in the amount of $85,598.51 and also disallowed special reproduction costs in the amount of $9691.20 due to a policy of the Clerk's office to leave taxation of such costs to the District Court.

On April 1, 1988, Respondents moved the District Court to retax the fees of the special master and the reproduction costs to Mr. Constant. Concurrently, Constant moved the district court to dismiss determination of costs, disallow costs and impose sanctions against defendants. At the hearing on May 2, 1988, the District Court granted Respondents' motion to retax costs and denied Constant's motion. The District Court ordered that the costs, totalling $123,832 be entered into and made part of the judgment entered in favor of Respondents. This order granting Respondents' Motion to Retax costs was entered on May 10, 1988

and is the subject of a separate appeal still pending before the Federal Circuit and not properly before this Court.[2]

SUMMARY OF ARGUMENT

The Federal Circuit properly determined the constitutionality of 35 U.S.C. Section 282 which permits the courts to adjudicate validity of patents when invalidity is raised as an affirmative defense in an infringement suit. While noting that judicial review of patents was accepted by the framers of the Constitution and Congress in the adoption of the first Patent Act in 1790, the Federal Circuit concluded that Congress was fully within its constitutional power when it delegated to the courts, in 35 U.S.C. Section 282, the power to determine validity in an action for patent infringement.

The Federal Circuit also properly determined that the *ex parte* reexamination procedure of the PTO did not divest the courts of the power to review patent validity and that such procedure was merely created by Congress as an additional mechanism to be used in the review of patents. Reexamination proceedings were never statutorily contemplated to replace judicial determinations of validity because they are limited in scope to printed prior art and not designed to consider all matters relating to validity such as prior offer for sale, which was most relevant in determining one of Petitioner's patents invalid.

The issue of whether the district court abused its discretion in its taxation of costs against Constant is not properly before this Court since, Constant has filed a separate appeal in the Federal Circuit (88-1414), which is still pending, on the issue of taxation of costs. The taxation of costs in a civil matter does not come within the excessive fines clause of the Eighth Amendment since the taxation of costs in a civil matter is not punitive in nature. The taxation of costs in a civil matter does not come within the

2. The taxing of costs was the subject of a separate appeal filed in the United States Court of Appeals for the Federal Circuit, *Constant* v. *Advance Micro-Devices, Inc., etc. et.al.*, Case No. 88-1414. No judgment on Case No. 88-1414 has been rendered by the Federal Circuit as of the date of filing the brief herein.

Eighth Amendment proscription against cruel and unusual punishment since this Eighth Amendment proscription only applies to one convicted of a crime and not to a civil litigant plaintiff who voluntarily seeks to litigate in the courts of the United States.

Constant's last issue is the only issue properly before this Court: were the summary judgments on the '635 and the '491 Patents improper. Constant's sole argument for granting his Petition is the purported refusal by the lower courts to follow *Graham* v. *John Deere & Co.*, 383 U.S. 1 (1966). This argument is totally frivolous and lacks merit, in that, the lower courts repeatedly cited, paraphrased and applied *Graham, supra,* in adjudicating the invalidity of Constant's patents.

ARGUMENT

I. THE FEDERAL CIRCUIT PROPERLY DECIDED THAT 35 U.S.C. SECTION 282 PERMITS THE FEDERAL COURTS TO ADJUDICATE THE VALIDITY OF PATENTS WHEN INVALIDITY IS RAISED AS AN AFFIRMATIVE DEFENSE IN AN INFRINGEMENT ACTION AND THAT THE CONGRESSIONAL CREATION OF THE PATENT AND TRADEMARK OFFICE REEXAMINATION PROCEDURE DID NOT DIVEST THE COURTS OF THE POWER TO REVIEW PATENT VALIDITY.

A. The District Court had Jurisdiction to Determine Validity.

Petitioner raises a red herring in suggesting that it was a denial of due process for the federal courts not to defer to the reexamination of Petitioner's patents by the Patent and Trademark Office ("PTO").

The Federal Circuit in reviewing Constant's challenge to the constitutionality of 35 U.S.C. Section 282, correctly determined that in interpreting the Patent and Copyright Clause of the Constitution, U.S. Const. Art.I Section 8, cl.8, the courts of the United States have "consistently construed the Patent and Copyright Clause to permit judicial review of patents." 848 F.2d at

1564. Congress has acted properly in enacting Section 282 which permits judicial review in an infringement action. The Federal Circuit further stated:

> Public policy requires that only inventions which fully meet the statutory standard are entitled to patents. This policy is furthered when the validity of a patent, which was originally obtained in *ex parte* proceedings in the PTO, can be challenged in court. *Lear, Inc.* v. *Adkins*, 395 U.S. 653, 670, 162 USPQ1, 8 (1969).
>
> "Within the limits of the constitutional grant, the Congress may . . . implement the stated purpose of the Framers by selecting the policy which in its judgment best effectuates the constitutional aim." *Graham*, 383 U.S. at 6, 148 USPQ at 462 . . . . Thus Congress has broad discretion on how to implement the conditions and tests for patentability. *Id.; McClurg* v. *Kingsland*, 42 U.S. (1 How.) 202, 206 (1843). Nowhere does the Constitution require that the determination of patent validity be vested solely in the PTO (or even that there be a PTO). Congress was fully within its constitutional power when it delegated power to the courts in 35 U.S.C. Section 282 to adjudicate the validity of patents in infringement suits.[3] Congress was also within its constitutional powers when it created a reexamination procedure as an additional mechanism for the review of patents.

848 F.2d 1564.

Thus the Federal Circuit properly determined that the district court had jurisdiction to review the validity of the Petitioner's patents.

B. Patent Office Reexamination Proceedings are Limited in Scope and Could not have Considered the Evidence that Contributed to a Finding of Invalidity in the District Court.

Plaintiff's attempt to confuse the issues in this case are transparent at best, since to divest the district court of its jurisdiction in favor of PTO reexamination would eliminate the bases for determination of invalidity in this action because PTO Reexamination

cannot consider the grounds used in the district court to invalidate one of Petitioner's patents: prior offer for sale under 35 U.S.C. Section 102(b).

Reexamination proceedings are limited to consideration of patentability over printed prior art, such as articles and patents. 35 U.S.C. Section 301. The Patent Examiner cannot consider unprinted prior art, such as prior devices or known products or techniques (Section 2258 of the *Manual of Patent Examining Procedure* (5th ed. 1983, rev. 1987). See also, 37 C.F.R. 1.552, and *In re Lanham*, 1 USPQ 2d 1877 (Com. Pat. 1986) where it is stated:

> Congress was aware when it passed the reexamination statute that the term 'prior art' encompassed more than patents and printed publications; *its intent was to have reexamination based solely on patents and printed publications.*

1 USPQ 2d at 1878. (Emphasis added).

This limitation of reexamination proceedings is significant because evidence that invalidating prior art devices were known and used in this country more than one year prior to the date of application for the patent in suit and before the alleged invention cannot be considered by the PTO and can only be considered in a district court proceeding.

Moreover, the Patent Examiner cannot, under reexamination regulations, consider whether or not Constant acted improperly during the original application for the patent. 37 C.F.R. Sections 1.552 and 1.555; *In re Lanham*, 1 USPQ 2d 1877 (Comm. Pat. 1986) (issues of fraud and inequitable conduct "not properly for consideration during reexamination"). Thus, even if the Patent Office could consider the validity of the patent over prior uses and knowledge, it could not consider whether other activities should render the patent unenforceable.

The Patent Examiner also cannot address the issue of whether or not arguments made by Constant during the prosecution of its original application resulting in the patent limit the scope of the claims ("file wrapper estoppel").

Reexamination proceedings are *ex parte* and one sided, and were designed to be so after the Patent Office's experience with inter partes proceedings. In 1977, the PTO adopted amendments to the Patent Office Rules wherein patent owners could file applications to reissue their patents and, in the process, cite prior art to the PTO. The public, under these rules was notified of the reissue application filed, and the public, including defendants who had been sued by the patent owner, were permitted to contest the reissue by participating with, for example, briefs, depositions transcripts, copies of documents obtained in discovery, and affidavits of experts and witnesses. Under these rules, it was not unusual in such contested re-issue proceedings for the PTO to conclude that the patent owner did not have a patentable invention.

In 1981, the PTO decided to stop the contested reissue proceedings since too much PTO time and resources were being consumed and the courts were more properly the place for such inter partes proceedings and the inter partes rules were repealed. In their place, pursuant to 35 U.S.C. Sections 302-07, the PTO instituted the far more limited, *ex parte* reexamination of patents. The PTO rules and procedures for reexamination repeatedly make clear that reexamination is intended to be, and will be, an *ex parte* proceeding (*Manual of Patent Examining Procedure,* sections 2209 and 2254).

Thus, it is disingenuous for Petitioner to suggest that district court determination of validity denies him full trial and due process when the reexamination procedure is an *ex parte* procedure not designed to determine all issues relating to validity.

Pursuant to 35 U.S.C. 302, any person may, at any time, file a request for reexamination; however, Mr. Constant has never requested reexamination of his patents. Mr. Constant has made a bold faced attempt to mislead this Court in claiming that he recommended reexamination in the courts below. (Petitioner's Brief at p.3.) Petitioner could have requested reexamination of his patents before he filed this action or even after he filed, but he did not: he voluntarily chose the federal courts to litigate his

patents and cannot now complain that Petitioners' exercise of their statutory rights, pursuant to 35 U.S.C. Section 282, in defense of the action he filed, in a forum chosen by him, is a denial of his due process rights.

II. THE DISTRICT COURT DID NOT ABUSE ITS DISCRETION IN ITS TAXATION OF COSTS AND SUCH TAXATION OF COSTS BY THE DISTRICT COURT IN A CIVIL ACTION DOES NOT CONSTITUTE AN EXCESSIVE FINE NOR CRUEL AND UNUSUAL PUNISHMENT PURSUANT TO THE EIGHTH AMENDMENT AND A DENIAL OF DUE PROCESS PURSUANT TO THE FIFTH AMENDMENT TO THE CONSTITUTION.

A. The Taxation of Costs in the District Court is not properly before this Court since it is still Pending before the Federal Circuit.

After judgment was entered by the district court on November 24, 1988, Constant filed two separate appeals: the first Federal Circuit No. 1101 which is the subject of Constant's Petition before this Court; and, the second, Federal Circuit No. 1414 which was an appeal from the district court's taxation of costs in the amount of $123,832 and the concurrent entry into and modification of the November 24, 1988 judgment. Judgment was entered in Federal Circuit No. 1101 on June 9, 1988; however, Federal Circuit No. 1414 is still pending. Accordingly, Constant's Petition as directed to the issue of costs taxed by the district court is not properly before this Court. Furthermore, Mr. Constant cannot now complain that the district court abused its discretion in the taxation of costs in light of the "low cost procedure for reexamination in the Patent Office under 35 U.S.C. 302 *et seq.*" (Pet. Br. at 9) when Mr. Constant, at no time sought reexamination, but did, in fact, choose to litigate in the courts of the United States.

B. The Taxation of Costs in a Civil Action does not come within the Purview of the Excessive Fines Clause of the Eighth Amendment nor does it Constitute Cruel and Unusual Punishment.

The Eighth Amendment has no application whatsoever to the taxation of costs in a civil action since the proscriptions of the Eighth Amendment apply only to those convicted of a crime and not to a civil litigant such as Mr. Constant who voluntarily chose to litigate his patents in the civil courts of the United States. *Ingraham* v. *Wright*, 430 U.S. 651 (1977); *Revere* v. *Massachusetts General Hospital*, 463 U.S. 239 (1983); *Palermo* v. *Rorex*, 806 F.2d 1266 (5th Cir. 1987). While due process protects rights of citizens who have not been convicted of crimes, the Eighth Amendment is applicable only to sentenced criminals. *Bailey* v. *Andrew*, 811 F.2d 366 (7th Cir. 1987). Further, while the applicability of the Excessive Fines Clause to civil punitive damages is "a question of some moment and difficulty" *Bankers Life & Casualty Co.* v. *Crenshaw*, 486 U.S. , 108 S. Ct. 1645, 1651 (1988) the taxation of costs in civil actions pursuant to 28 U.S.C. Section 1920 is not punitive in nature.

C. There has been no Abuse of Discretion in the Appointment of the Special Master

Mr. Constant failed to object to Mr. Hillman when he was appointed as Special Master to advise the court on the issues raised in the Summary Judgment motions in August of 1986. Constant only objected to Mr. Hillman and his report after Mr. Hillman indicated that both patents were invalid in January and February, 1987 (848 F.2d at 1563). Constant's attack on Mr. Hillman is nothing more than a losing litigant's "sour grapes."

The appointment of a Special Master is lodged in the sound discretion of the trial court. *Crateo, Inc.* v. *Intermark, Inc.*, 535 F.2d 862, 868 (9th Cir. 1976); *Macri* v. *United States*, 353 F.2d 804, 809 (9th Cir. 1965). Constant consented to the Special Master and has failed to demonstrate any abuse of discretion whatsoever in the appointment of Mr. Hillman.

III. NO REASONS ARE RAISED BY CONSTANT ABOUT WHY A WRIT OF CERTIORARI SHOULD BE GRANTED TO REVIEW THE FEDERAL CIRCUIT'S AFFIRMANCE OF THE DISTRICT COURT'S JUDGMENT OF PATENT INVALIDITY

Constant's last issue addresses the only issue properly before this Court: Were the summary judgments on the '635 and '491 patents improper. Constant's sole argument for granting his petition is the lower courts' purported refusal to follow an earlier decision of this Court—a decision that those courts repeatedly cited, paraphrased and applied. Thus, Constant's petition merely reiterates what the Federal Circuit labelled as virtually frivolous arguments. *Constant*, 848 F.2d at 1570.[3]

Constant premises his challenge to the decisions below upon the purported failure of the lower courts to make the factual inquiries on the issue of obviousness[4] enumerated in *Graham* v. *John Deere & Co.*, 383 U.S. 1 (1966).[5] (Pet. for Certiorari at 12). However, *Graham* provides no reason for this Court to devote its finite resources to this case.

Clearly, the Federal Circuit's analysis of *Graham* does not conflict with the decision of any other circuit court or any other

3. The Federal Circuit devoted special attention in both the opening *and* the closing of its opinion about the frivolity of Constant's appeal. That court stated "[b]ecause of appellant's earnest efforts to support his positions, we deal with them in greater detail than their merits deserve." 848 F.2d at 1563. In closing, the court stated:

> The district court went to great lengths to be fair and has shown great patience in the face of arguments and tactics that would have been improper if advanced by a lawyer. . . . Appellant is hereby cautioned that if he persists by trying to raise again the same issues that have been finally decided by the district court or by this court, he could be sanctioned. . . . *id.* at 1572.

4. Section 103 provides that "[a] patent may not be obtained . . . if the differences between the [claims] and the prior art are such that the subject matter as a whole would have been obvious. . . ."

5. In *Graham, supra*, this Court interpreted Section 103 of the Patent Act to require a four part test comprised of: (i) the scope and content of the prior art; (ii) differences between the prior art and the claims; (iii) the level of ordinary skill in the art; and (iv) secondary indicia of nonobviousness such as the commercial success of the invention. *Id.* at 17.

court. Since 1982, all appeals in patent cases have been lodged in the Federal Circuit to "'reduce the widespread lack of uniformity . . . in . . . patent law.'" *Christianson* v. *Colt Industries Operating Corp.*, 486 U.S. , 108 S. Ct. 2166, 100 L.Ed. 2d 811, 828 (1988). Thus, conflicts are unlikely with one court having particular legal expertise in patents lodged with exclusive jurisdiction.

Nor is this a case where the lower courts' decisions conflict with the applicable holdings of this court. This Court's *Graham* decision is inapposite to many of the conclusions on invalidity made below. Numerous claims[6] were found to be invalid below due to a lack of novelty under 35 U.S.C. Section 102(b);[7,8] thus, for those claims, the courts below never addressed the obviousness of those claims under 35 U.S.C. Section 103.

Graham, however, only sets forth the standards for determining validity under Section 103. The *Graham* court carefully noted that Section 102 governed the issue of novelty and refrained from addressing that issue. *Graham,* 383 U.S. at 13.[9] Thus,

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6. The patent owner's invention, and therefore its right to exclude the defendant from making, using and selling the accused device under 35 U.S.C. Section 154, is defined by the claims. An analogy exists between the claims of a patent and the legal description of the property in a deed. The claims describe the intellectual property of the patent owner while the legal description in the deed describes the landowner's real estate. See *In re Vamco,* 752 F.2d. 1564, 1577 n.5 (Fed. Cir. 1985). Using this analogy, infringement (the making, using or selling the claimed invention) is similar to the tort of trespass while patent invalidity is analogous to a defect in the title of real property.

7. Section 102(b) provides that "[a] person shall be entitled to a patent unless . . . (b) the invention was . . .described in a printed publication in this or a foreign country or . . . on sale in this country more than one year prior to the date of the application for patent in the United States . . ." 35 U.S.C. Section 102(b). Although the term new appears in Section 101 of the Patent Act in the context of defining what is patentable, Section 102(b), defines what, for the purposes of patent law, is old, and therefore, unpatentable. See *Titanium Metals Corp. of America* v. *Banner,* 778 F.2d 775, 781 (Fed. Cir. 1985).

8. The district court held and the Federal Circuit affirmed that claims 1, 2, 6-9, and 11-14 of the '635 Patent and claims 1, 7, 8, 9, 16, 18, 21, 22 and 23 of the '491 Patent were not new under 35 U.S.C. Section 102(b). *See Constant,* 848 F.2d at 1568, 1570.

9. See also *Lewmar Marine, Inc.* v. *Barient, Inc.*, 827 F.2d 744, 747-48 (Fed. Cir. 1987) (explaining the historical evolution of the separation of the

Graham is irrelevant to the lower court's determination of patent invalidity on many of the claims. Therefore, even assuming *arguendo* that the courts below failed to follow *Graham*, that failure would have no effect on the soundness of substantial portions of the opinions below.

Even for those remaining claims that were held to be obvious, Constant does not and cannot demonstrate any issue meriting this Court's use of its limited resources. Although Constant claims the courts below failed to follow *Graham* that is simply false. The district court below referred to and paraphrased *Graham* in both of its invalidity opinions. (*See* Conclusion of Law No. 7 on the '635 Patent, Pet. App. at B31); Conclusion No. 1 on the '491 Patent (incorporating by reference Conclusions Nos. 1-9 on the '635 Patent), Pet. App. at B58. The Federal Circuit noted that the district court had properly considered *Graham*. *Constant*, 848 F.2d at 1569.

Even a cursory examination of the district court's decisions demonstrates a religious devotion to the four factor *Graham* test. First, the district court carefully determined that the publications relied upon by the Respondents below were within the scope and content of the prior art. *See* Findings of Fact Nos. 20-31 on the '635 Patent (Pet. App. at B14-B20); Findings of Fact Nos. 14-32 on the '491 Patent (Pet. App. at B44-B54). Second, the district court carefully noted the difference between the claims and the prior art. *See* Findings of Fact Nos. 19, and 33-40 on the '635 Patent (Pet. App. at B14 and B21-B25); Findings of Fact Nos. 34 and 35 (Pet. App. at B55-B58). Third, the district court determined that there was no issue of fact on the level of skill in the field of the patents. *See* Finding of Fact No. 33 on the '491 Patent (Pet. App. at B 54); Finding of Fact No. 32 on the '635 Patent (Pet. App. at B20). Finally, the lower courts considered the secondary or objective indicia of nonobviousness raised by Constant such as commercial success. See *Constant*, 848 F.2d at

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legal tests for invalidity under sections 102 and 103); *Argus Chemical Corp.* v. *Fibre Glass-Evercoat Co.*, 759 F.2d 10, 14 n.5 (Fed. Cir. 1985) (Miller, J. concurring).

1572 (the "evidence consisted of arguments and conclusory statements"). Thus, the lower courts properly applied the *Graham* tests.

Constant's final argument that this Court should overturn the lower courts decisions due to "clearly erroneous" statements about the technology warrants little comment here. Of course, none of these technical complaints relate to the alleged failure of the lower courts to follow *Graham* or any other reason why this Court should devote its limited energies to this matter.[10]

Further, his other arguments concerning the validity of the '491 Patent are meritless. Although Constant urges that the district court invalidated his '491 Patent because it fails to disclose a computer program (Petition at 16), that is not so. The district court and the Federal Circuit concluded that the prior art did not have to include a computer program to anticipate that patent. *See* Finding of Fact No. 32 on the '491 Patent (Pet. App. at B43); 848 F2d at 1569.[11]

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10. Given the extreme technical nature of the patents (the level of skill in the art on the subject patents was a doctorate in electrical engineering or physics, *See* Finding of Fact No. 32 on the '635 Patent, Pet. App B20-B21). Respondents respectfully submit that there is no need to for this court to delve into these extremely technical issues. Further, it is worth noting that the district court used a Special Master who while being a noted patent attorney also had degrees in physics and mathematics from the Massachusetts Institute of Technology (Finding of Fact No. 6; Pet. App. B5-B6). Similarly, the Federal Circuit has technical advisors on its staff to help that court understand complicated technology and the members of that court are acknowledged experts in patent law.

11. It is clear that Petitioner realized that the technology (i.e. Respondent Intel's 2920 chip and its associated publications) which Respondents relied upon to invalidate the '491 patent was identical to the alleged inventions in the '491 patent. This is shown by Petitioner's first letter to Respondent Intel which was written *prior* to the present lawsuit, which letter charged Intel with infringement of the '491 Patent because of that technology (i.e. the 2920 chip). That letter was cited by the District Court and stated, "Your 2920 Signal Processor infringes Claims 1, 7, 8, 9, 16, 18, and 23, as minimum of my enclosed patent [the '491 Patent]." *Constant* v. *Advanced Micro-Devices*, District Court No. 85-0262 SVW (Bx) at Findings of Fact No. 19, Pet. App. at B46p-B47. This enumeration of specific claims is nearly identical to the claims found anticipated under 35 U.S.C. 102(b). Intel responded to that letter by noting that the 2920 chip and its associated publications pre-dated the '491 Patent, but Constant

Similarly, Constant's closing complaints regarding the prior art publications failure to disclose "semiconductor RAM[12] having $\log_2 n$ lines" deserve short shrift by this Court. Constant argues that his claims should be interpreted to include these purported requirements. Yet, these terms appear nowhere in the claims and his '635 patent states that the memories "'may be any one of a number of types, the exact type to be determined by the application.'" *Constant*, 848 F.2d at 1571 (quoting the '635 patent). If the limitations of the "semiconductor RAM having $\log_2 n$ lines" were read into the claims as Constant demands, the claims would not serve their legal purpose of defining the patented subject matter. *See* 35 U.S.C. Section 112; *Constant*, 848 F.2d at 1571.

In conclusion, Constant's charge that the lower courts failed to follow *Graham* is frivolous. In its short existence, the Federal Circuit has shown its fanatical devotion to *Graham* by citing that case in 115 opinions and be repeatedly admonishing district courts that strayed from *Graham's* teachings. *See, e.g., Jones* v. *Hardy*, 727 F.2d 1524 (Fed. Cir. 1984). Here, the district court and the Federal Circuit cited, paraphrased and properly applied *Graham's* four factor test. Thus, no reason exists for this Court to devote its limited resources to a technically complex and unimportant patent case.

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nevertheless sued Intel in this litigation for infringement of the '491 Patent because of the 2920. As clearly demonstrated in the record, Intel had been developing the 2920 chip for several years prior to the filing date of the '491 Patent, and Intel had sold and described that chip in publications, more than one year prior to the filing date of the '491 Patent, (see Findings of Fact Nos. 14, 16 and 17 for the '491 Patent, Pet. App. B44-B46). Thus the very technology which Petitioner claimed was infringing his patent was on sale and described in publications more than one year prior to the filing date of that patent. Thus, the only issue that ever existed was one of who got there first, that is, anticipation.

12. RAM means random access memory. A memory is a device that is used in computers for storing information in a computer; in random access memories, the information can be stored or reviewed in any order, irrespective of the physical location within the memory. A semiconductor RAM is merely a particular type of RAM.

IV. CONCLUSION

For the reasons set forth below, the Respondents herein submit that a writ of certiorari should not be granted in this case.

Respectfully submitted,

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PROOF OF SERVICE BY MAIL

I am a citizen of the United States and a resident of the City of Washington, District of Columbia; I am over the age of eighteen years and not a party to the within action; my business address is: 2021 L Street, N.W., Washington, D.C. 20008.

On September 16, 1988, I served the Brief for Respondents in Opposition in re: "James Constant v. Advanced Micro-Devices" in the Supreme Court of the United States on Petition for Writ of Certiorari to the United States Court of Appeals for the Federal Circuit; on the parties in said action, by placing three copies thereof enclosed in a sealed envelope with postage fully prepaid, in the United States post office mail box at 20th and M Streets, Washington, D.C., addressed as follows:

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I certify under penalty of perjury under the laws of the United States that the foregoing is true and correct.

Executed on September 16, 1988 at 2021 L Street, Washington, D.C.

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